FILED

94 811 NOV 2 1994

OFFICE OF THE CLERK

No. _____

In The

Supreme Court of the United States

October Term, 1994

MELVIN WALLSHEIN,

Petitioner,

v.

CABLESTRAND CORPORATION,

and

ALLAN B. WEISS,

Respondents.

Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

MYRON GREENSPAN
154 Girard Street
Brooklyn, New York 11235
(718) 646-1500
(914) 723-4300

Counsel for Petitioner

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTIONS PRESENTED

1. Is a district and/or appellate court's predisposition against a particular case because of its complexity of the subject matter ("complex subject matter bias") and/or the time and effort that must be devoted to the case when the Court has a heavy docket ("heavy docket bias"), and subsequent actions consistent with such predisposition, a bias any less insideous than other forms of bias that have been addressed by this Court or a lesser reason to disqualify the biased Court, and have any decision rendered by that Court remanded for re-examination by a court that does not exhibit such bias?

2. Did the District Court's arbitrary reversal of its own Judgment when the appellate court merely remanded for the completion of the Judgment by the issuance of Findings of Fact and Conclusions of Law, without an intervening trial or a motion to amend the Judgment, violate Petitioner's right to due process and equal protection of the laws under the U.S. Constitution?

3. Have the repeated failures by the District Court and the CAFC to follow the applicable Rules of Procedure denied Petitioner his rights to due process and equal protection of the laws under the U.S. Constitution?

QUESTIONS PRESENTED – Continued

4. Was the summary dismissal of Petitioner's cause of action on grounds that are not supported by the evidence adduced at trial but merely for the convenience of the courts a denial of Petitioner's rights of due process and equal protection of the laws under the U.S. Constitution?

5. Can a district court adopt, substantially *verbatim*, a party's pre-trial proposed Findings of Fact without regard to the trial record and contrary to the evidence adduced at trial without violating rights to due process and equal protection of the laws under the U.S. Constitution?

6. Has the Petitioner been denied equal protection of the laws under the U.S. Constitution where the CAFC failed to uniformly apply its established standards of review in assessing the District Court's actions and decisions in order to avoid addressing "complex" issues on appeal?

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
TABLE OF AUTHORITIES	v
PETITION FOR WRIT OF CERTIORARI	1
OPINIONS BELOW	1
JURISDICTION	1
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED	2
STATEMENT	2
1. Summary	2
2. Background	3
REASONS FOR GRANTING THE PETITION	12
Summary	12
FAILURE BY THE DISTRICT COURT AND THE CAFC TO FOLLOW THE FEDERAL RULES OF PROCEDURE WAS A VIOLATION OF PETITIONER'S RIGHT TO DUE PROCESS AND EQUAL PROTECTION OF THE LAWS	13
REVERSAL BY DISTRICT COURT OF JUDGMENT I, ON REMAND TO ISSUE FINDINGS OF FACT AND CONCLUSIONS OF LAW SUPPORTING ITS JUDGMENT, WITHOUT INTRODUCTION OF NEW EVIDENCE, IS CONTRARY TO LAW AND IS A VIOLATION OF PETITIONER'S FIFTH AMENDMENT RIGHT TO DUE PROCESS	17

TABLE OF CONTENTS – Continued

Page

COPYING OF PRE-TRIAL PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW WITHOUT INDEPENDENT EVALUATION OF THE EVIDENCE AT TRIAL IS TANTAMOUNT TO HAVING NO TRIAL AT ALL AND IS A VIOLATION OF FIFTH AMENDMENT RIGHT TO DUE PROCESS 20

THE DISTRICT COURT IGNORED CRITICAL FACTS THAT REQUIRED A FINDING OF INFRINGEMENT 22

THE ARBITRARY DISMISSAL OF PATENT INFRINGEMENT CLAIM EFFECTIVELY DIVESTED PETITIONER OF HIS PATENT RIGHTS AND GRANTED A COMPULSORY LICENSE TO AN INFRINGER IN VIOLATION OF FIFTH AMENDMENT RIGHT TO DUE PROCESS AND ARTICLE I, SECTION 8, CLAUSE 8 OF THE U.S. CONSTITUTION 24

THE CAFC'S ABUSE OF ITS DISCRETION IN FAILING TO APPLY ITS OWN STANDARDS OF REVIEW AND OPTING TO AVOID "COMPLEX" ISSUES BY FINDING NON-INFRINGEMENT DENIED PETITIONER EQUAL PROTECTION OF THE LAWS 25

THE COURTS BELOW DENIED PETITIONER'S FIFTH AMENDMENT RIGHT TO DUE PROCESS BY THEIR "COMPLEX SUBJECT MATTER BIAS" AND/OR "HEAVY DOCKET BIAS" 27

CONCLUSION 30

APPENDIX A 1a

APPENDIX B 8a

APPENDIX C 10a

TABLE OF CONTENTS – Continued

Page

APPENDIX D 27a

APPENDIX E 28a

APPENDIX F 33a

APPENDIX G 36a

APPENDIX H 40a

APPENDIX I 41a

TABLE OF AUTHORITIES

Page

CASES

Baltimore & O.R. Co. v. United States, 298 U.S. 349 (1936) 20

Cablestrand v. Wallshein, 989 F.2d 472 (Fed. Cir. 1993) 6, 7

Goldberg v. Kelly, 397 U.S. 254 (1970) 27

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367 (Fed. Cir. 1986) 25

Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 730 F.2d 1452 (Fed. Cir. 1984) 25

Mayberry v. Pennsylvania, 400 U.S. 455 (1971) 27

Mayview Corp. v. Rodstein et al., 620 F.2d 1347 (Fed. Cir. 1980) 25

Minnesota Mining & Manufacturing Co. v. Norton Co., 929 F.2d 670 (Fed. Cir. 1991) 25

Morissey v. Brewer, 408 U.S. 471 (1972) 27

In re Murchison, 349 U.S. 133 (1955) 27

PPG Industries v. Celanese Polymer Specialties Co., 840 F.2d 1565 (Fed. Cir. 1988) 25, 26, 27

Rolls-Royce Ltd. v. GTE Valeron Corp., 800 F.2d 1101 (Fed. Cir. 1986) 25

United States v. Crescent Amusement Co., 323 U.S. 173 (1944) 19

TABLE OF AUTHORITIES – Continued

Page

STATUTES

UNITED STATES CODE

28 U.S.C. § 1254(1) 2

28 U.S.C. § 1291 ..... 2, 16

28 U.S.C. § 1295(a)(1) 2, 16

28 U.S.C. § 1338(a) 2, 16

28 U.S.C. § 2072(a) 2, 14

Title 35, United States Code 24

FEDERAL RULES OF PROCEDURE

Rule 1 F.R.Civ.P. 2, 14, 15

Rule 43(a) F.R.Civ.P. 19

Rule 52(a) F.R.Civ.P. 2, 7, 8, 9, 15, 18, 19, 21

Rule 59 F.R.Civ.P. 2, 12, 15

Rule 77(d) F.R.Civ.P. 9, 19

UNITED STATES CONSTITUTION

Article I, Section 8, Clause 8 ..... 2, 24

Article III 13

Fifth Amendment 2, 17, 20, 27

Fourteenth Amendment 2

TABLE OF AUTHORITIES – Continued

Page

OTHER AUTHORITIES

American Constitutional Law, Lawrence H. Tribe, 2nd Ed. 1988, p. 744 21

"The Essays or Counsels – Civil and Moral" Sir Francis Bacon, 1597, Essay LVI "of Judicature" 22

PETITION FOR WRIT OF CERTIORARI

Melvin Wallshein respectfully petitions for a writ of certiorari to review the decisions of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The Decision and Judgment of the United States Court of Appeals for the Federal Circuit (hereinafter "CAFC") dated May 24, 1994 is attached as Appendix A (App., 1a-7a).[1] A "Notice of Intended Judgment And Order Thereon", issued by the United States District Court for the Central District of California (hereinafter "District Court") on May 29, 1992 (hereinafter "Judgment I") is attached as Appendix B (App., 8a-9a.) The Findings Of Fact and Conclusions of Law and Judgment of the District Court (hereinafter "Judgment II") are attached as Appendix C (App., 10a-26a). Also, attached as Appendix D (App., 27a) is a copy of the Order of the CAFC denying petition for rehearing and declining suggestion for rehearing *in banc* (hereinafter "Petition and Suggestion").

JURISDICTION

The Judgment of the CAFC was entered on May 24, 1994. The Petition for Rehearing and Suggestion for Rehearing *in banc* was denied on July 5, 1994. On September 23, 1994, Chief Justice William H. Rehnquist extended the time to file a petition for a writ of certiorari to and

---

[1] Page references to the Appendix to this Petition are referred to as (App.,).

including November 2, 1994. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8, Clause 8 of the U.S. Constitution, the Fifth Amendment Due Process Clause of the U.S. Constitution, and the Fourteenth Amendment Equal Protection of the Laws Clause of the U.S. Constitution; 28 U.S.C. §§ 1291, 1295(a)(1), 1338(a), 2072(a); and Rules 1, 52(a), and 59 F.R.Civ.P.

STATEMENT

1. Summary

Petitioner, Melvin Wallshein, has been *repeatedly* denied due process and the equal protection of the laws under the U.S. Constitution, *inter alia*, for the following reasons:

1. The District Court and the CAFC have repeatedly refused to follow the Federal Rules of Civil Procedure (hereinafter "Rules of Procedure") and have insisted on summarily and arbitrarily dismissing Wallshein's substantial and constitutionally-based causes of action, for patent infringement of his two valid U.S. Patents, merely because this facilitated the quick dispositions of these causes of action for reasons that have nothing to do with the trial record or the evidence adduced at trial.

2. The CAFC improperly entertained a first Appeal I, and ordered Wallshein to proceed with the appeal and incur the expenses of a full briefing schedule, when the

CAFC knew (because the CAFC was so informed by the Petitioner) that Judgment I was not ready for appeal.

3. The District Court acted contrary to the law when it reversed its own Judgment I in favor of Petitioner, without a motion, without a new trial and without any new evidence.

4. The District Court's actions were contrary to the law by ignoring critical evidence adduced at trial, when it adopted as its own a party's pre-trial proposed findings of fact and conclusions of law that were inconsistent with Judgment I, without independently evaluating the evidence and without making even a single reference to the trial record, including testimony of witnesses, exhibits admitted into evidence, and critical admissions that strongly supported a finding of infringement.

5. The CAFC's actions were contrary to the law when it refused to apply its own standards of appellate review, but instead devised an excuse for summarily disposing Appeal II to avoid what it (the CAFC) termed "complex" issues, which otherwise the CAFC would have to address.

2. Background

Petitioner, Melvin Wallshein (hereinafter "Wallshein") is an individual who has devoted most of his adult and professional life developing orthodontic devices and appliances to facilitate and improve orthodontic procedures, and, as a result of his efforts, has been granted more than one hundred U.S. patents. Two of these patents, U.S. Patent Nos. Re. 30,332 and Re. 30,593

(hereinafter the " '332 Patent" and " '593 Patent", respectively, or collectively as the "Patents") were the subject of the litigation before the District Court. This Petition is requesting review of the Decisions of the CAFC[2] and Judgment II of the District Court.

The initial Action (CV-84-4219) (hereinafter "Action I") was filed by Cablestrand Corporation (hereinafter "Cablestrand") on June 6, 1984, for a declaratory judgment against Wallshein. Cablestrand sought declarations that it had not infringed Wallshein's '332 and '593 Patents by the manufacture and sale of multi-strand coaxial orthodontic arch wire (hereinafter "Cablestrand Product"); *and* that said Patents are invalid and/or unenforceable. Wallshein counterclaimed for Patent infringement.

On December 31, 1987, more than three years after Action I was commenced, and shortly before the scheduled trial, Cablestrand sought re-examination of both Patents in the United States Patent and Trademark Office (hereinafter "USPTO") and, on the eve of trial, moved to stay the trial. That motion was granted.

At the end of the re-examination the patentability of all the claims in both Patents were affirmed.[3] After Petitioner learned that Cablestrand had little or no assets to satisfy any judgment that might be granted to Wallshein, a second action (CV-89-4329) (hereinafter "Action II") was instituted by Wallshein, on July 19, 1989, against

---

[2] The CAFC effectively affirmed Judgment I (namely, that there is no infringement), though on a totally different theory conceived by the CAFC which, however, was technically unsound and totally lacked support in the trial record.

[3] All the claims were affirmed without any amendments.

Allan B. Weiss (hereinafter "Weiss"), an attorney who is the President of Cablestrand.

Actions I and II were consolidated, and a bench trial was conducted before District Court Judge Robert M. Takasugi from April 30 to May 3, 1991. On May 29, 1992, *more than one year after the trial,* Judge Takasugi issued a one and one-half page Judgment I entitled "Notice of Intended Judgment and Order Thereon." Judgment I stated that:

> "The Court, *after careful and full examination of the evidence* relating to liability, has ruled as follows:
>
> 1. that defendant Melvin Wallshein takes judgment against plaintiff Cablestrand Corporation on defendant's counterclaim [for patent infringement] . . . defendant Weiss is awarded judgment on CV-89-4329-RMT." (Emphasis added.)

In Judgment I the District Court necessarily held that:

1. Both Patents were valid and enforceable;

2. Cablestrand's Product infringed the Patents; and

3. The defenses of laches and equitable estoppel were not established by Cablestrand and/or Cablestrand could not avail itself of those defenses.

Judgment I also required all parties to submit memoranda addressing the applicable remedies and damages available to Wallshein. All parties fully complied with Judgment I by filing memoranda with Judge Takasugi addressing the issues of willfulness and monetary damages.

After the required memoranda were filed, but *before* the District Court rendered its Findings of Facts and Conclusions of Law, Cablestrand and Weiss filed an appeal to the CAFC as to the portion of Judgment I relating to Action I. To preserve his rights, Wallshein filed a cross-appeal relating to the portion of Judgment I dealing with Action II. (Both of these initial appeals will hereinafter be collectively referred to as "Appeal I".)

Without Findings of Fact or a written decision setting forth the District Court's findings, Appeal I was clearly not ready for appeal. Wallshein immediately, orally and in writing, urged Cablestrand, Weiss, *and the CAFC* that Appeal I was premature and should be dismissed or held in abeyance until the District Court had issued its Decision and/or Findings and Conclusions.[4] Cablestrand and Weiss vigorously argued to the CAFC that Appeal I was final and ready for appeal. The CAFC ordered Wallshein to proceed with Appeal I and file his briefs.[5] As anticipated by Petitioner, after Wallshein incurred the expense of a full briefing schedule, the CAFC, in a decision dated March 8, 1993,[6] admitted that Judgment I was *incomplete* and dismissed Appeal I, *vacating* Judgment I, and stating:

---

[4] Wallshein, an individual, also urged the CAFC that Appeal I was not ready for appeal because he wanted to avoid an expensive briefing schedule, which was clearly an exercise in futility.

[5] Copies of the relevant correspondence from the attorney from Respondents and from the CAFC, and the CAFC's Order directing the parties to proceed with the "ill-fated" Appeal I are attached as Appendix E (App., 28a-32a).

[6] *Cablestrand v. Wallshein*, 989 F.2d 472 (Fed. Cir. 1993). A copy of this decision is attached as Appendix F (App., 33a-35a) for the convenience of this Court.

> "No findings of facts or conclusions of law were filed in accordance with Fed. R. Civ. P. 52(a); none are shown in the transcript or referred to on the docket sheet. The issues argued on appeal, which include patent validity, infringement, laches, estoppel, and personal liability,[7] are not mentioned. The parts of the record provided in the appendix show contradictory evidence adduced in four days of trial, on the many fact dependent issues pressed during the trial."[8]

Without referring to its own prior decision ordering Wallshein to proceed with the aborted Appeal I the CAFC stated:

> "It may be that the *final judgment* was entered prematurely, and that the notices of appeal prematurely divested the district court of jurisdiction. *Whatever the reason, in this complex case,* without the findings of fact and conclusions of law, *we have no basis on which to review the appealed judgment* . . . (case citations omitted.)" (Emphasis added.)

The CAFC then ordered, *inter alia,* that:

1. Judgment I entered May 29, 1992 be vacated;[9] and

---

[7] These are the issues, it appears, that neither the District Court nor the CAFC were inclined to review.

[8] *Cablestrand v.Wallshein, supra,* at 473. (App., 33a-34a).

[9] The District Court's May 29, 1994 Judgment I consisted of two parts. The first was an announcement of its holding of its "intention" to find for Wallshein on the issues of infringement, validity, laches and equitable estoppel, and the second was an Order for further briefs. The additionally requested briefs were all timely filed so that nothing remained to be complied with. It was contrary to the law to vacate what was left, namely, the District Court's holding of its "intent" to find for Wallshein.

2. The case be *remanded for Findings of Fact and Conclusions of Law* in accordance with Rule 52(a) F.R.Civ.P.

On June 3, 1993, *more than two years after the trial*, the District Court, *sua sponte*, without any new evidence, *reversed itself*[10] and entered Findings of Facts and Conclusions of Law and a Judgment *contrary* to its own Judgment I holding:

1. No infringement of the '332 and the '593 Patents;

2. The '332 and the '593 Patents are unenforceable as "barred by the Doctrine of Laches.";

3. Wallshein will "have and recover nothing" on the infringement counterclaim in Action I or on the infringement Complaint in Action II; and

4. Wallshein to pay costs.

The Findings of Facts and Conclusions of Law were rendered contrary to law *more than two years after the trial* without any intervening hearings, etc. The District Court *copied essentially verbatim* the findings and conclusions *proposed by Cablestrand and Weiss prior to the trial.* Naturally, such Findings *did not and could not* contain a single reference to the trial transcript nor to any piece of evidence admitted during the trial. Attached as Appendices III and IV to Wallshein's Main Brief were tables[11] correlating the District Court's Findings and Conclusions with

---

[10] **The District Court's reversal of its own Judgment I was without a new trial or hearing, without any new evidence and without any order from an appellate court.**

[11] **Copies of Appendices III and IV submitted to the CAFC are attached as Appendix G (App., 36a-39a).**

the *pre-trial proposed findings*. In his briefs Wallshein referenced the trial record to identify the errors made by the District Court and to indicate why the *copied* findings and conclusions bore no connection to the evidence at trial, including Cablestrand's and Weiss' own expert witnesses. The District Court, after pointing out that "The Notice of Entry stamp under F.R.C.P., Rule 77(d) was erroneously placed by the [District Court] clerk", stated:

> "However, Cablestrand proceeded with an appeal from this Notice of Intended Judgment prior to this court issuing its Findings of Fact, etc. Most recently, this court received a remand from the CAFC for failing to file said Findings of Fact, etc. *This compelled the court to review and reexamine its prior ruling . . . This court now intends to clarify this misunderstanding . . . After due consideration and reconsideration of the merits of the case, this court issues the following:"* (Emphasis added.)

The Findings of Fact and Conclusions of Law, and the judgment thereon, were appealed in the second Appeal II. In briefing the issues in Appeal II, Wallshein alerted the CAFC of the District Court's mysterious and unwarranted reversal of its own Judgment I, the abnormal delays between decisions,[12] the frivolity of the defenses, and the strong evidentiary support shown even by Cablestrand's and Weiss' own witnesses for a finding of infringement.

---

[12] More than one year passed between the trial and the first one and one-half page Judgment I. More than two years elapsed before the District Court complied with the CAFC's mandate to issue Findings of Facts and Conclusions of Law under Rule 52(a) F.R.Civ.P.

At the commencement of oral arguments before the CAFC, counsel for Wallshein was instructed by the Appellate Panel not to state the factual background since the Panel had "read" the briefs and was familiar with the case. However, when counsel for Wallshein stated that the District Court had reversed itself, on remand to issue findings and conclusions, at least one of the Panel members showed total surprise and asked for confirmation that this had occurred. Thereafter, the Panel dwelled on the definition of a "lumen"[13] for almost the entire time allotted for oral argument, when a member of the Panel asked whether a finding of non-infringement would render moot the remaining issues of laches and Weiss' personal liability.[14]

On May 24, 1994, the CAFC "affirmed" the ultimate determination of the District Court.[15] In its decision, The CAFC determined that it need not decide whether the District Court's interpretation of the term "lumen" was accurate. Instead, the CAFC found no infringement

---

[13] The record was replete with definitions of "lumen", a term used in the Patents, including dictionary definitions and testimony of witnesses. All of these were included in the Joint Appendix on appeal and discussed extensively in the briefs.

[14] The CAFC appears to have relied on this point in rendering its decision. See Footnote 2 on Page 2 of Decision, after observing that the case and the issues therein were, according to the CAFC, "complex." Appendix A (App., 2a). It is evident from such comments, on the record, that the CAFC was inclined, from the beginning, to dispose of Appeal II in a summary manner that would require the least amount of judicial input.

[15] The decision, written by Judge Schall, with Judge Newman concurring in the result, does not indicate the position or concurrence (or lack thereof) by Judge Plager, the third Judge on the Panel.

because evidence of infringement included "microphotographs" (prepared as an aid to the District Court to show separations on the order of 0.015mm[16]) made with the assistance of a microscope. The CAFC decided, for the first time in this ten year litigation, that the use of microscopes is somehow unacceptable[17] and that the "separations" recited in the claims must "be of some magnitude *greater* than microscopic."[18] The CAFC, therefore, affirmed the *conclusion of non-infringement* without affirming any specific Finding of Fact. On June 6, 1994, Wallshein filed a Petition for Rehearing and Suggestion for Rehearing *in Banc*, alerting the CAFC that its Decision was contrary to its own precedents regarding claim construction, burden of proof, and standards for judicial review, and once again arguing that the District Court *did not consider the evidence adduced at trial.* Because the District Court *copied essentially verbatim Cablestrand's and Weiss' pre-trial proposed findings of facts and conclusions of law*, Wallshein argued before the CAFC that the District Court's Findings of Facts and Conclusions of Law were *not* entitled to the "clearly erroneous" standard of review. Both the Petition and Suggestion were denied without opinion.

---

[16] Trial Exhibit 1119 is attached as Appendix H (App., 40a). Many of the relevant physical dimensions are no greater than the thickness of a human hair, the details of which the average eye cannot see without the aid of a microscope.

[17] Cablestrand was the first to use microscopes and photomicrographs in Action I in a motion for summary judgment.

[18] The Court did not explain in what "microscopic" meant or how the *valid* claims of Wallshein's Patents should be interpreted under the Court's ruling.

In the Petition and the Suggestion, Wallshein strenuously argued that he had received no judicial input, despite being forced to litigate for ten years, and being forced by the CAFC to endure the hardships and expenses of two full appeals (one of which was ultimately dismissed to correct the CAFC's own premature acceptance of an appeal before it was ready for review). In his Petition, Wallshein also pointed out that if the District Court was permitted to simply adopt pre-trial proposed Findings of Facts and Conclusions of Law that have *no bearing* on the evidence admitted at trial, that this was *tantamount to having no trial at all.* Under those circumstances, Wallshein argued that he has been denied due process. The CAFC evidently had no problem here and totally ignored the issue.

REASONS FOR GRANTING THE PETITION

Summary

The District Court denied Wallshein his constitutionally guaranteed right to due process when it proceeded contrary to Rule 59 F.R.Civ.P. by reversing itself, on remand solely for Findings of Fact and Conclusions of Law, *more than two years* after the trial and without hearing any new evidence which would warrant such a reversal.

The District Court denied Wallshein due process by adopting pre-trial proposed Findings of Fact and Conclusions of Law without independently evaluating the trial evidence and without supporting those adopted findings with even a single reference to the evidence adduced at trial.

The CAFC denied Wallshein due process by needlessly forcing him to incur the expenses of Appeal I when the CAFC was alerted by Wallshein that Appeal I was not ready because the District Court's Judgment I was not complete.

Wallshein was denied due process by both the District Court and the CAFC when they failed to give Wallshein any judicial input because of "complex subject matter bias" and/or "heavy docket bias" due to the inability or lack of desire by these courts to study a large and/or complex record on appeal.

The CAFC denied Wallshein equal protection under the law when it refused to uniformly apply its own standards of review.

Wallshein was denied due process and equal protection of the laws when both the District Court and the CAFC acted contrary to the law by failing to follow the Federal Rules of Civil Procedure, as aforementioned.

FAILURE BY THE DISTRICT COURT AND THE CAFC TO FOLLOW THE FEDERAL RULES OF CIVIL PROCEDURE WAS A VIOLATION OF PETITIONER'S RIGHTS TO DUE PROCESS AND EQUAL PROTECTION OF THE LAWS

United States Federal District Courts and Courts of Appeals are courts created under Article III of the U.S. Constitution. Therefore, these courts are created by and regulated by Congress. Title 28, which has created these courts, has given this Court the power to prescribe rules of practice and procedures " . . . in the United States District Courts . . . and courts of appeals." 28 U.S.C.

§ 2072(a). Pursuant to this section this Court has promulgated the Federal Rules Of Civil Procedure for the district courts and the Federal Rules of Appellate Procedure for the courts of appeal (hereinafter collectively "Rules of Procedure"). It is clear that under Section 2072(a) the Rules of Procedure apply equally to the courts as well as to litigants.

The District Court and the CAFC have, in this case, flagrantly violated fundamental Rules of Procedure and, therefore, have acted beyond the scopes of their authorities. This Court, which has promulgated the Rules of Procedure, must insure that the Rules of Procedure are fully and uniformly complied with. Failure to do so will not only create an immediate, grave and irreversible injustice to Petitioner, and *de facto* approval of the unlawful actions of these lower courts, but will establish a precedent that will directly and inevitably cut into the integrity of the entire judicial system.

As stated by Edmund Burke:

> Justice is itself the great standing policy of civil society; and any eminent departure from it, under any circumstances, lies under the suspicion of being no policy at all.

This Court has set that "great standing policy" as it relates to the conduct within the courts, which is to consistently provide a level playing field for litigants and "secure the just, speedy, and inexpensive determination of every action." Rule 1 F.R.Civ.P. Though this Rule may not be frequently cited by litigants, attorneys or judges, it does define the scope of the Rules of Procedure and the policy behind them.

While the Petitioner is merely one litigant, this Court must be cognizant that a breakdown of the Rules of Procedure in even one case not only violates important rights of due process and equal protection of the laws but tarnishes the system. Flagrant disregard or benign neglect of the integrity of the Rules of Procedure, particularly by the courts, must result in judicial inefficiency, turmoil and loss of respect for the system. The judiciary, starting with this Court, must show a strong dedication to the Rules of Procedure and set the example for others. If the courts are permitted to flagrantly violate the Rules of Procedure, can they seriously expect others to follow them?

Here, the District Court acted contrary to at least Rules 1, 52(a) and 59 F.R.Civ.P., and the CAFC effectively approved such unlawful actions.

As will be evident from this Petition, the District Court did not adjudicate the rights of the parties in a "speedy" manner[19] as required by Rule 1 F.R.Civ.P., waiting more than one year after trial to issue the one and one-half page Judgment I. Additionally, the District Court failed to *find* the facts specially as required by Rule 52(a) F.R.Civ.P., instead copying essentially *verbatim pre-trial proposed* findings of fact and conclusions of law that *do not reflect the evidence* introduced during the trial. In fact, the District Court's findings are *totally unsupported* by the trial record and omit to make reference to critical trial evidence that strongly supported an opposite conclusion consistent with Judgment I. Finally, the District Court totally ignored Rule 59 F.R.Civ.P. Motions for new trials

---

[19] Judge Takasugi acknowledged an abnormal delay in rendering Judgment I (App., 9a).

(whether at the initiative of a party or a court) and amendments or alterations of judgments *must* be initiated within 10 days after entry of the judgment. While amendments may be made *by motion* of a party, a court can only order a *new trial* within 10 days after entry of the judgment. Here, the District Court reversed its own decision (Judgment I) approximately *one year* after Judgment I issued ruling in favor of Wallshein. The *sua sponte* reversal of its own decision was *ultra vires* because it was not in response to a motion of a party, it occurred more than ten days after entry of Judgment I and it occurred without a new trial or the introduction of any new evidence.

Congress has specified that all courts of appeals have jurisdiction over appeals "from all final decisions of the district courts". 28 U.S.C. § 1291. The CAFC is similarly limited in its jurisdiction by 28 U.S.C. § 1295(a)(1) in the cases of appeals based, in whole or in part, on 28 U.S.C. § 1338(a) of Title 28. Thus, if Judgment I was final[20] and if the CAFC had jurisdiction it should have remanded for issuance of findings (as it did), but without vacating Judgment I since the CAFC had not yet reviewed the merits of the appeal[21] and had no way of establishing whether Judgment I was properly decided on the facts and the law. On the other hand, if Judgment I was not

---

[20] Both the CAFC and Respondents treated Judgment I as "final." Respondents took that position when arguing that Appeal I was ready for review (App., 29a-31a), and the CAFC treated Judgment I as a final judgment (albeit without findings) in its September 29, 1992 Order (App., 32a) and its Decision. (Exhibit F) (App., 32a-35a).

[21] The CAFC has admitted that it had " . . . no basis on which to review the appealed judgment . . . " Appendix F (App., 34a).

final, the CAFC had no jurisdiction and had neither the right nor the power to vacate Judgment I. Since the CAFC treated Judgment I as final, vacating Judgment I by CAFC was *ultra vires*.

In view of the foregoing, it is clear that the District Court and the CAFC skirted the Rules of Procedure and exercised options that they simply and legally did not have. It is easy for lower court, given their frequently unquestioned discretion, to abuse the Rules of Procedure, intentionally or inadvertently, particularly when they are burdened by heavy dockets and increasingly complex issues. Abuses can result in "shortcuts" useful in disposing of burdensome cases. However, it is not for the lower courts to take these matters into their own hands. This Court must firmly monitor adherence to the Rules of Procedure to insure that they are consistently followed to uphold the integrity of the judicial system while, at the same time, insure litigants the protection of important Constitutional rights.

REVERSAL BY DISTRICT COURT OF JUDGMENT I, ON REMAND TO ISSUE FINDINGS OF FACT AND CONCLUSIONS OF LAW SUPPORTING ITS JUDGMENT, WITHOUT INTRODUCTION OF NEW EVIDENCE, IS CONTRARY TO LAW AND IS A VIOLATION OF PETITIONER'S FIFTH AMENDMENT RIGHT TO DUE PROCESS

As indicated above, the District Court waited *more than one year* before it issued its one and one-half page Judgment I holding for Wallshein on the issues of infringement, laches, and equitable estoppel as against Cablestrand. Undoubtedly, during that time the District

Court handled numerous other cases. (App., 9a). Whatever its recollections of the trial were on May 27, 1992 (one year after the trial) when Judgment I was signed by the District Court, it is clear that those recollections were much dimmer on May 28, 1993 (*one year later and two years after the trial*) when the same court signed the mandated Findings of Fact and Conclusions of Law.

The instructions issued by the CAFC were merely for the District Court to issue findings of fact and conclusions of law, in accordance with Rule 52(a) F.R.Civ.P. – nothing more and nothing less. In reversing itself, the District Court stated that the remand " . . . *compelled* the court to review and reexamine its prior ruling." However, the CAFC did not even remotely suggest that a reexamination was required. Since the CAFC admitted that it did not have a complete record on Appeal I, the CAFC *did not* and *could not* address the merits of the case. Indeed, since the District Court had indicated that it had *carefully* and *fully* reviewed the evidence upon the issuance of the Judgment I, it is illogical that it could reverse itself without hearing a shred of new evidence. How could the CAFC believe that a *later* examination would be better or more accurate than the first, particularly since it had not reviewed Appeal I on the merits and the alleged later examination took place more than two years after the trial? Moreover, the CAFC was alerted that the later action, on remand to the District Court, consisted in merely copying, *substantially verbatim*, pre-trial proposed findings of facts and conclusions of law, and that these

findings did not contain even a single reference to the evidence profferred at trial or to the trial transcript.[22]

Also, the District Court did not explain why it was necessary to "clarify this misunderstanding." What misunderstanding? The only "misunderstanding" alluded to by the District Court was the *ministerial or mechanical error* by its own clerk, in a post appeal determination, that it had "erroneously" placed a notice of entry stamp under Rule 77(d) F.R.Civ.P. Surely, this was no justification for reversing Judgment I *on the merits* in favor of Wallshein.

It was only at the time that Judgment I was issued that the District Court asserted that it had made a "careful and full examination of the *evidence*." When the court issued its Findings and Conclusions (Judgment II) it *did not state* that it reviewed the evidence, but only that it "considered and reconsidered the merits of the case." It is clear that the only "consideration and reconsideration" by the District Court was to devise a convenient way to streamline its own responsibilities and quickly dispose of

---

[22] Such systematic copying of findings, especially *pre-trial proposed* findings, is contrary to, if not the letter, the spirit of Rule 52(a) F.R.Civ.P. The Notes relating to the 1946 Amendment of this Rule stated: "These findings should represent the judges's own determination and not the long, often argumentative statements of successful counsel", citing *United States v. Crescent Amusement Co.*, 323 U.S. 173 (1944). This is precisely what the District Court did in this case-copy *pre-trial* argumentative statements of counsel, without any connection or correlation to anything that transpired at the trial. Rule 43(a) F.R.Civ.P. requires that all testimony be given orally in open court (so that the trial judge can hear and independently evaluate such testimony and serve as a trier of the facts).

a long, nagging and "complex" litigation, and had nothing to do with a review of the trial record or the evidence admitted at trial.

Due process requires that a litigant be permitted to introduce evidence and be issued judicial findings based on "consideration of all the evidence." *Baltimore & O.R. Co. v. United States*, 298 U.S. 349, 372 (1936). The unwarranted reversal, therefore, by the District Court, of its *own* Judgment I arrived after due consideration of the evidence, is totally contrary to law, and as such is inconsistent with the Rules of Procedure and the Federal Rules of Evidence, and a denial of Wallshein's due process under the Fifth Amendment to the U.S. Constitution. It is without justification that the CAFC not only failed to act on a critical irregularity but totally ignored it and did not even refer to this unwarranted reversal in a footnote.

COPYING OF PRE-TRIAL PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW WITHOUT INDEPENDENT EVALUATION OF THE EVIDENCE AT TRIAL IS TANTAMOUNT TO HAVING NO TRIAL AT ALL AND IS A VIOLATION OF FIFTH AMENDMENT RIGHT TO DUE PROCESS

The formal procedural safeguards ordinarily held to be required by due process – *the right to be heard and the right to hear why* – are ultimately more understandable as inherent in the decent treatment of people than to minimize mistakes. When God asked Adam if he had eaten of the tree of life, the Midrash explains, the point of the exchange was less to minimize the risk of divine error than to afford Adam a moment to regain his composure. Such procedural formalities that are implicit in treating

people with respect as members of the community should thus be required of due process for reasons more basic than any utilitarian calculus of accuracy, although accuracy of course matters as well when the procedure is ancillary to a substantial interest of great importance to the individual and to society. *American Constitutional Law*, Laurence H. Tribe, 2nd Ed., 1988, p.744. Here, while the District Court ostensibly provided Wallshein the "right to be heard," it is clear that the court did not and could not have given him the "right to hear why" since it did not perform its judicial functions pursuant to the Rules of Procedure. Instead, the District Court merely copied, essentially *verbatim*, fictitious pre-trial proposed findings of fact that had nothing to do with what transpired during the trial.

The threads of due process also manifest themselves in Rule 52(a) F.R.Civ.P., which requires that:

> "In all actions tried upon the facts without a jury or with an advisory jury, the court *shall find the facts specially* and state separately its conclusions of law thereon." (Emphasis added.)

Clearly, to find the facts "specially" requires the court to sift through the facts and evidence introduced and admitted during the trial, to weigh the evidence and the credibility of the witnesses and make an *independent* evaluation and determination of the evidence, so that the court can make its mandated findings of fact. The blind copying of pre-trial proposed findings or picking and choosing pre-trial findings for the convenience *of the court* is entirely unlawful and a clear breach of due process of the parties. As stated by Sir Francis Bacon:

> "Patience and gravity of hearing is an essential part of justice . . . The parts of a judge in hearing

> [requires him] . . . to recapitulate, select, and collate the material points of that which hath been said . . . "[23]

While the District Court provided a physical courtroom presided over by a judge, the extraordinary delays, the copying of pre-trial proposed findings substantially *verbatim* (without one single reference to trial exhibits or trial testimony) and the reversal of its own Judgment I more than *two years* after trial, make it abundantly clear that the District Court did not independently evaluate the evidence or render its judgment on the evidence. Under those circumstances, it is respectfully submitted, the proceedings in the District Court were the equivalent to having no trial at all. In fact, Wallshein would have been better off without a trial because, without the judicial input to which he was entitled, the actions by the District Court were totally arbitrary and Wallshein, an individual, could have avoided the substantial expenses of a trial and, of course, the subsequent expenses of multiple appeals.

THE DISTRICT COURT IGNORED CRITICAL FACTS THAT REQUIRED A FINDING OF INFRINGEMENT

As further and confirming proof that the District Court did not consider the evidence, Cablestrand and Weiss submitted testimony of *their own* experts, who made critical admissions *supporting infringement*, that were totally ignored by the District Court. In addition to testifying that certain test results submitted to the court

---

[23] *"The Essays Or Counsels-Civil And Moral"*, Sir Francis Bacon, 1597, Essay LVI "Of Judicature." The orderly execution of such judicial responsibilities is referred to as "judicial input" by Petitioner in this Petition.

were false, one of these experts, Dr. Larry McKnight, admitted on cross-examination, that *if the core of the Cablestrand Product could be removed, then the Cablestrand Product would infringe the Patents in suit. Dr. Raymond Thurow, indeed, demonstrated effortless removal of the core from a Cablestrand Product in open court.*[24] The District Court may not have found this evidence determinative on the issue of infringement, but its failure to even comment or acknowledge that it was part of the record is not only astonishing but confirms Petitioner's observations that the CAFC was more interested in disposing of the appeal than reviewing the actions of the District Court.[25] It is clear that any reasonable judge who evaluated the evidence during the trial of this action, and in particular the aforementioned evidence, had to have reached a different finding on the issue of infringement or, at the least, had to, in all fairness to Wallshein, explain why the aforementioned testimony by Dr. McKnight and the demonstration by Dr. Thurow was not persuasive or why it would be given little or no weight. This need was intensified in the present case because the District Court originally agreed with the expert witnesses and found infringement but later, and without explanation, reversed itself. The District Court, when pressured to issue findings of fact and conclusions of law, took the path of least resistance. Any reasonable person, evaluating what has occurred in this litigation would immediately see that the District Court

---

[24] Appropriate pages from the Appeal II Joint Appendix are attached as Appendix I (App., 41a-47a).

[25] This is particularly true since Cablestrand and Weiss made such removal a cornerstone of their frivolous defense of non-infringement (since the claims do not require removal of the core wire for a finding of infringement) and such defense was nevertheless dramatically negated in open court.

decided to copy pre-trial proposed findings of fact and conclusions of law that would dispose of the matter with the least amount of effort or time, while minimizing the probability of appeal as well as risk of reversal on appeal. Upholding the validity of the patents in suit (consistent with the reexamination decisions of the USPTO affirming the validity of all of the claims in both of the patents), and finding non-infringement, would eliminate many other complex issues that the District Court would not have to resolve. In so doing, the District Court merely copied pre-trial proposed findings of fact. No correlation was made between these pre-trial findings and the actual evidence adduced at trial.

THE ARBITRARY DISMISSAL OF PATENT INFRINGEMENT CLAIM EFFECTIVELY DIVESTED PETITIONER OF HIS PATENT RIGHTS AND GRANTED A COMPULSORY LICENSE TO AN INFRINGER IN VIOLATION OF FIFTH AMENDMENT RIGHT TO DUE PROCESS AND ARTICLE I, SECTION 8, CLAUSE 8 OF THE U.S. CONSTITUTION

Article I, Section 8, Clause 8 of the U.S. Constitution grants to Congress the power:

> "To promote the Progress of Science . . . by securing for limited times to . . . Inventors the *exclusive* Right to their . . . discoveries" (Emphasis added.)

The Congress having created a Patent Act[26] that provides for the issuance of patents, and Wallshein having been granted the two Patents in suit pursuant to the Act, the validity of both of which have been upheld both by the District Court as well as by the USPTO, Wallshein had a

---

[26] Title 35, United States Code.

vested right to the *exclusive* use of the inventions covered by the Patents.

If, as Wallshein contends, the District Court did not independently evaluate the evidence and arbitrarily copied, almost *verbatim*, pre-trial proposed findings of fact for its own convenience, the effect of the denial to Wallshein of due process under the Fifth Amendment to the U.S. Constitution, was to deny Wallshein his exclusive patent rights and to grant Cablestrand and Weiss a compulsory royalty-free license for the balance of the terms of the Patents in suit.

THE CAFC'S ABUSE OF ITS DISCRETION IN FAILING TO APPLY ITS OWN STANDARDS OF REVIEW AND OPTING TO AVOID "COMPLEX" ISSUES BY FINDING NON-INFRINGEMENT DENIED PETITIONER EQUAL PROTECTION OF THE LAWS

No doubt the CAFC had a heavy docket, just as the District Court did, when it issued its two rulings. However, that is not a reason to "bend" the standards of review, which the CAFC has defined in a line of its own cases.[27] Yet, notwithstanding the fact that the CAFC was advised that the District Court made a finding of infringement "after careful and full examination of the evidence," only to reverse itself *more than two years* after the trial, that the District Court copied pre-trial proposed

---

[27] *Mayview Corp. v. Rodstein et al.*, 620 F.2d 1347 (Fed Cir. 1980); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 730 F.2d 1452 (Fed. Cir. 1984); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986); *Rolls-Royce Ltd. v. GTE Valeron Corp.*, 800 F.2d 1101 (Fed. Cir. 1986); *PPG Industries v. Celanese Polymer Specialties Co.*, 840 F.2d 1565 (Fed. Cir. 1988); *Minnesota Mining & Manufacturing Co. v. Norton Co.*, 929 F.2d 670 (Fed. Cir. 1991).

findings *virtually verbatim*, that the "findings of fact" were totally unrelated to the evidence introduced at the trial, that critical evidence strongly supporting a finding of infringement was totally ignored by the District Court, the CAFC nevertheless applied the "clearly erroneous" standard and did not comment in relation to any of the aforementioned abnormalities. The case law is clear: where a party's pre-trial proposed findings are adopted by the trial court, such findings are subject to a "heightened scrutiny." In this case, in light of the District Court's numerous "irregularities" brought to the attention of the CAFC , this "heightened scrutiny" was essential but not forthcoming. In fact, after suggesting that it was "affirming" the District Court's findings, the CAFC proceeded to "dispose" of the appeal on a totally new theory which was conceived by the CAFC but had no basis whatsoever in the trial record. The CAFC, in its fervor to dispose of the appeal, clearly sought to find a basis for a finding of non-infringement. The fact that such basis, like the District Court's findings, was without support from the trial evidence and rendered the otherwise definite patent claims indefinite, did not appear to trouble the CAFC. Whether its zeal to summarily dispose of the appeal was because of the court's heavy docket or because it did not wish to review numerous issues which it had earlier observed to be "complex" is, of course, not known. However, it is respectfully submitted that neither excuse is or can be valid or lawful.

Under some circumstances the copying of pre-trial proposed findings, which are contrary to the actual evidence, is contrary to the law. *PPG Industries v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). Since the District Court's findings are simply not plausible in light of the substantial physical evidence and are

actually inconsistent with the testimony of Respondents' own expert witnesses, the findings are clearly erroneous and the CAFC was in error in refusing to apply its own standards of review but, instead, seeking a way "out" so as to dispose of the appeal in the quickest and easiest way. As the CAFC has itself stated, referring to abuse of discretion, "you know it when you see it." *PPG Industries, supra*, at 1570-1. Here, the CAFC was alerted to all of the irregularities and abuses of discretion by the District Court. Yet, although any reasonable person would "see it", the CAFC refused to do so because it was easier and quicker to dispose of the "complex issues" by conceiving a simple theory of non-infringement. This violated Wallshein's right to equal protection of the laws.

THE COURTS BELOW DENIED PETITIONER'S FIFTH AMENDMENT RIGHT TO DUE PROCESS BY THEIR "COMPLEX SUBJECT MATTER BIAS" AND/OR "HEAVY DOCKET BIAS"

A fair trial in a fair tribunal is a basic requirement of due process. *In re Murchison*, 349 U.S. 133, 136 (1955).

This Court has always stressed the *intrinsic* aspects of neutrality almost as much as its instrumental aspects, focusing on the "moral authority" of the law as well as on the *accuracy* of its application. Since the "appearance of even-handed justice . . . is at the core of due process," *Mayberry v. Pennsylvania*, 400 U.S. 455, 469 (1971), a court may disqualify decisionmakers who *appear* to be biased even if, in fact, they "have no actual bias". *Morissey v. Brewer*, 408 U.S. 471, 485-86 (1972); *Goldberg v. Kelly*, 397 U.S. 254, 271 (1970).

If the decisionmaker appears biased on the basis of religion, race or financial interest there would clearly be a good ground to suspect a resulting decision, and to set it

aside if such bias, or even the appearance of bias, could be demonstrated. It is clear that the aforementioned forms of bias, which have frequently been addressed by this court, are merely examples and are not exhaustive or exclusive. In fact, *any form of bias* that has the effect of disturbing the neutrality of the decisionmaker is, it is respectfully submitted, equally objectionable and should be treated in precisely the same way.

Regrettably, there are forms of bias that are equally insidious although they have not been extensively addressed by this Court.[28] Two forms of such bias that appear to have played a significant role during this litigation are (1) "complex subject matter bias,"[29] and (2) "heavy docket bias."[30] These biases do not arise in every

---

[28] Since judges are human, it is to be expected the judges will harbor many, if not all, of the same biases encountered in the population at large. It is suggested that, in addition to the two forms of bias raised in this section, another common form of bias is "geographical" bias by judges inclined to favor "local" parties and/or attorneys or disfavor parties or attorneys from other regions.

[29] District Court judges have been known to voice their opinions, even on the record, that they "dislike" technologically complex cases, most frequently patent cases. It was partially because of the prevalence of this form of bias, and resulting inconsistencies in the treatment of patents in the different district and circuit courts of appeals, that the CAFC (a central appellate court for all patent appeals) was formed to provide more uniformity in the application of the patent laws throughout the county.

[30] Judge Takasugi acknowledged his "grueling and extended trial schedule during the past year" (App., 9a) to explain why it took more than one year after trial to issue Judgment I. (Two years in the case of Judgment II) However, the problem raised by such excessive delays, which unquestionably

case in which the subject matter is complex or when a court has a heavy docket. While most judges appear to control minor biases so that they do not materially affect the judges' neutrality or impartiality in a given case, it is clear that in some cases, as exemplified by this case, the overriding desires or needs by the lower courts to quickly dispose of time-consuming or complex cases prevent judges from being truly impartial or fair to one or more parties. What levels of bias are inevitable and tolerable and when do such levels exceed the threshold to violate important constitutional rights? Here, it is clear that neither the district court nor the CAFC had the time or interest to fully evaluate the subject matter of this case. Where it would be clearly evident to any reasonable judge, attorney or impartial person that a court is taking "shortcuts" and seeking ways to avoid sorting through complex and/or an extensive trial record, and a final decision has no relation to the trial evidence, as is the case here, one of these two aforementioned forms of bias must be suspect.

In this case, the highly "irregular" actions of the District Court and the statements on the record by the CAFC that this is a "complex" case make it abundantly clear that both of these courts streamlined their obligations as trial and appellate courts, in total contravention to the U.S. Constitution, the statutes enacted by Congress and the Rules of Procedure promulgated by this Court. As such, the lower tribunals were guilty of being partial to the "path of least resistance" and, as a result, have

---

dim the memories of judges, is analogous to laches, which penalizes litigants because, *inter alia*, the memories of witnesses may dim due to unreasonable delays by litigants in bringing suit.

demonstrated that they were biased courts that have denied Wallshein due process and equal protection of the laws by acting more in their own interests than those of the parties.

CONCLUSION

It is not clear whether Shakespeare would have classified the herein proceedings in the lower courts as a comedy of errors or tragedy. What is clear is that without this Court's strong affirmation to the lower courts that they must follow The Federal Rules of Procedure, what has occurred in this case is but one example of how the judicial system can run amuck. As stated by Johann Kasper Lavater:

> He who has no taste for order, will be often wrong in his judgment, and seldom considerate or conscientious in his actions.

Only this Court can restore and impose order in the lower courts.

For the reasons stated above, a Writ of Certiorari should be issued to review the judgments and opinions of the CAFC and the District Court.

This 2nd day of November, 1994.

Respectfully submitted,

MYRON GREENSPAN
Attorney for Petitioner

154 Girard Street
Brooklyn, New York 11235
(718) 646-1500
(914) 723-4300

APPENDIX A

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals
for the Federal Circuit

93-1490

CABLESTRAND CORPORATION,

Plaintiff-Appellee,

v.

MELVIN WALLSHEIN,

Defendant-Appellant,

MELVIN WALLSHEIN,

Plaintiff-Appellant,

v.

ALLAN B. WEISS,

Defendant-Appellee.

DECIDED: May 24, 1994

Before NEWMAN, PLAGER, and SCHALL, *Circuit Judges.*

SCHALL, *Circuit Judge.*

DECISION

Melvin Wallshein, the named inventor of U.S. Reissue Patent Nos. 30,332 (the '332 patent) and 30,593 (the '593 patent), appeals from the May 28, 1994 Judgment of the United States District Court for the Central District of California, case no. CV 89-4329. In the opinion accompanying the judgment, the district court concluded that (i) the accused "Six Strand Wire" sold by Cablestrand Corporation (Cablestrand) did not infringe the '332 patent or the '593 patent, either literally or equivalently; (ii) Allan B. Weiss, president of Cablestrand, could not be held personally liable for the debts of Cablestrand; and (iii) any rights Wallshein may have had against Cablestrand and/or Weiss prior to bringing the present infringement claims were barred by laches. We affirm on the ground of no literal infringement[1] and therefore do not reach the other issues decided by the district court.[2]

DISCUSSION

I

Determining whether a patent is infringed involves a two-step inquiry: (1) interpreting the claims; and (2) comparing the properly interpreted claims to the accused device. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821, 23

---

[1] On appeal, Wallshein does not challenge the district court's finding of non-infringement under the doctrine of equivalents.

[2] Wallshein's counsel agreed during oral argument that an affirmance on the issue of non-infringement would render moot the issues of laches and Weiss' personal liability.

USPQ2d 1426, 1431 (Fed. Cir. 1992). Claims are construed as a matter of law by the district court, and the construction given the claims is reviewed *de novo* by this court of appeal. 970 F.2d at 822, 23 USPQ2d at 1432. The comparison of the properly construed claims to the alleged infringing structure, the ultimate question of infringement, is a matter of fact, reviewed for clear error by this court in the case of a bench trial. *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1125, 227 USPQ 577, 589 (Fed. Cir. 1985) (*in banc*). Wallshein, as owner of the '332 and '593 patents, bears the burden of proving infringement by a preponderance of the evidence. *Mannesmann DeMag Corp. v. Engineered Metal Prods., Co.*, 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986).

II

Each of the independent claims in dispute (claim 1 in the '332 patent and claim 52 in the '593 patent) is directed to an "arch wire" used in orthodontic applications – for example, to secure braces on a patient's teeth in a predetermined positional relationship. Because the two independent claims are very similar (claim 1 relates to an orthodontic arch wire, whereas claim 52 relates to the same wire in combination with an orthodontic bracket), claim 1 of the '332 patent may be viewed as representative of the invention in the appeal. In relevant part, claim 1 recites that the arch wire comprises a plurality of "strands coiled in the form of a tightly wound elongated coiled wire having an array of interleaved turns . . . and having a lumen extending therethrough." Much of the litigation in the district court focused on the definition of the term "lumen" and whether the accused Six Strand

Wire had one. However, based on our conclusion below that the Six Strand Wire did not possess another limitation recited in the asserted claims, we need not review either the district court's interpretation of the term "lumen" or its ultimate finding that one was lacking in the accused wire.

Claim 1 further recites that the strands making up the arch wire are "made from a material sufficiently elastic to at least permit bending of the arch wire over a short length thereof by selectively and at least partially separating adjacent turns." The district court interpreted this language as requiring that adjacent turns of the arch wire, upon being bent, must separate by a certain minimum amount. Although it did not specify the precise minimum separation amount, the district court concluded that this limitation was not met by the accused wire because "[t]here is no separation between adjacent turns in the bent Cablestrand Six Strand wire which would allow food particles to become lodged between the adjacent turns."

Wallshein argues that the district court committed reversible error in its interpretation of the "at least partially separating adjacent turns" limitation. In support of his view, Wallshein essentially contends that the phrase "at least partially separating" includes any degree of separation, no matter how small or microscopic, which, as a consequence of physical principles, inherently must be present in all bent, flexible wires. We disagree and hold that, as a matter of law, the district court correctly construed claim 1 as requiring a certain minimum amount of separation between adjacent turns upon bending the arch wire. This interpretation of the claims necessarily follows from application of the rule that "[a]ll the

limitations of a claim must be considered meaningful." *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562, 19 USPQ2d 1500, 1504 (Fed. Cir. 1991) (citing *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532-33, 3 USPQ2d 1321, 1324-25 (Fed. Cir. 1987)). Wallshein states that separations of at least microscopic proportions are "absolutely dictated by the geometries and properties of the materials and [occur] whenever there is bending of a wire of the type under discussion. . . . " In other words, under Wallshein's interpretation, the phrase "at least partially separating adjacent turns" is merely a truism describing a phenomenon dictated by the laws of physics, and which occurs in *every* wire of this type including those in the prior art. Apparently, Wallshein would have us hold that the disputed phrase is mere surplusage. Construing the claim language at issue as a statement of truism must be rejected, however, for it "would render meaningless [an] express claim limitation[ ]." *Unique Concepts*, 939 F.2d at 1563, 19 USPQ2d at 1504. *See also Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171, 26 USPQ2d 1018, 1023 (Fed. Cir. 1993) (rejecting a patentee's proffered claim construction because it "would render the disputed claim language mere surplusage."). Therefore, in order to give effect to the disputed language, we conclude that the separations between adjacent turns must be of a magnitude somewhat greater than microscopic.

Keeping the above claim interpretation in mind, we observe that the only evidence proffered by Wallshein that separations are present in the accused wire consists of photomicrographs allegedly showing microscopic separations in a bent Six Strand Wire. Consequently, because

we have concluded that a proper interpretation of the claims in suit requires that the separations be of some magnitude *greater* than microscopic, Wallshein's claim of literal infringement was defeated by a failure of proof.

COSTS

Each party shall bear its own costs.

NEWMAN, *Circuit Judge,* concurs in the result.

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals
for the Federal Circuit

Judgment

ON APPEAL from the United States District Court for the Central District of California

in CASE NO(S). 84-4219 and 89-4329

This CAUSE having been heard and considered it is ORDERED and ADJUDGED: *AFFIRMED*

ENTERED BY ORDER OF THE COURT

/S/ Francis X. Gindhart
Francis X. Gindhart, Clerk

Dated MAY 24, 1994

ISSUED AS A MANDATE: JUL. 12, 1994

APPENDIX B

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

CABLESTRAND CORPORATION, a California corporation, Plaintiff, vs. MELVIN WALLSHEIN, an individual, Defendant.	No. CV 84-4219-RMT
MELVIN WALLSHEIN, an Individual, Plaintiff, vs. ALLAN B. WEISS, an individual, Defendant.	No. CV 89-4329-RMT NOTICE OF INTENDED JUDGMENT AND ORDER THEREON (Filed May 29, 1992)

The court, after careful and full examination of the evidence relating to liability, has ruled as follows:

1) That defendant Melvin Wallshein takes judgment against plaintiff Cablestrand Corporation on defendant's counterclaim and that defendant Weiss is awarded judgment on CV89-4329-RMT.

The parties are ordered to file a Memorandum of Points and Authorities and argument, not to exceed ten

(10) pages in total, addressing the issue of defendant's remedies in addition to a proposed Judgment. The defendant shall file same on or before June 15, 1992, and plaintiff shall respond by June 25, 1992. The Memoranda shall address wilfulness and the monetary damages sought.

The court extends its appreciation for the patience extended by the parties during this court's grueling and extended trial schedule during the past year.

Dated: 5/27/92

/s/ Robert M. Takasugi
ROBERT M. TAKASUGI
United States District Judge

APPENDIX C

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

CABLESTRAND CORPORATION, a California corporation, Plaintiff, vs. MELVIN WALLSHEIN, an individual, Defendant.	No. CV 84-4219-RMT
MELVIN WALLSHEIN, an individual, Plaintiff vs. ALLAN B. WEISS, an individual, Defendant.	No. CV 89-4329-RMT(Tx) FINDINGS OF FACT AND CONCLUSIONS OF LAW (Filed May 28, 1993)

INTRODUCTION

An initial action (CV84-4219-RMT) ("Action I"), was filed by plaintiff Cablestrand Corporation ("Cablestrand") against defendant Melvin Wallshein ("Wallshein") for a judicial declaration that it has not infringed U.S. Patent Nos. Re. 30,332 and Re. 30,593, and that such patents are invalid and/or unenforceable. Wallshein filed a counterclaim in Action I against Cablestrand

seeking an injunction against continued infringement in addition to other remedies.

Wallshein, in CV89-4329 ("Action II"), initiated a subsequent action against Allan B. Weiss ("Weiss") for patent infringement. Actions I and II were consolidated.

On or about May 29, 1992, this court issued a Notice of Intended Judgment along with an Order for additional briefing on the issue of damages. Upon receipt of the written memorandum of points and authorities, the court intended to prepare and file its complete Findings of Fact and Conclusions of Law and its Judgment. The Notice of Entry stamp under F.R.C.P., Rule 77(d) was erroneously placed by the clerk.

However, Cablestrand proceeded with an appeal from this Notice of Intended Judgment prior to this court issuing its Findings of Fact, etc. Most recently, this court received a remand from the Circuit Court of Appeals for failing to file said Findings of Fact, etc. This compelled the court to review and reexamine its prior ruling.

This court now intends to clarify this misunderstanding.

After due consideration and reconsideration of the merits of the case, this court issues the following:

FINDINGS OF FACT

I.

Cablestrand is a corporation organized under the laws of the state of California, and having its principal place of business in Long Beach, California. Wallshein is

an individual having a principal place of business in Brooklyn, New York. Weiss is an individual residing in the state of California, having a principal place of business in Long Beach, California. Weiss is the president of Cablestrand.

II.

Federal jurisdiction is invoked upon the grounds that this is a civil action involving a case of actual controversy within the jurisdiction of this court arising under 28 U.S.C. § 2201, and that this is a civil action arising under an Act of Congress relating to patents (28 U.S.C. § 1338(a)). Federal jurisdiction also exists in that this is a civil action arising under the laws of the United States (28 U.S.C. § 1331). Venue exists in the district in that the claims involved in this action arose in this district (28 U.S.C. § 1391(b)).

III.

Wallshein is a practicing orthodontist who has filed for an [sic] obtained at least seventy-six issued United States patents and a number of corresponding foreign patents.

IV.

Cablestrand is a manufacturer of wire used as orthodontic archwire as well as wire used for other purposes.

V.

On July 26, 1976, Wallshein filed a United States Patent Application, Number 708,304, directed to an orthodontic archwire comprised of a plurality of adjacent strands coiled in turns with a lumen extended throughout. The material used for the strands was sufficiently pliable tc allow bending of the archwire to at least partially separate adjacent turns of the archwire. This application was examined by the United States Patent and Trademark Office and was issued on May 2, 1978, as United States Patent No. 4,086,702.

VI.

In early 1978, Cablestrand's then president, Michael E. Henry, developed an orthodontic archwire referred to as the Six Strand wire, which is accused of infringement in this suit. The Six Strand wire does not have a lumen or passageway extending through the archwire, and the adjacent turns of the archwire do not separate upon bending.

VII.

The manufacture and sale of the Six Strand wire was commenced in or about February, 1978, by Cablestrand without Cablestrand or Weiss having any knowledge of Wallshein's United States Patent No. 4,086,702.

VIII.

In 1978, shortly after the product was first introduced, Wallshein obtained some of the Six Strand wire from Ormco and concluded that it infringed his United States Patent No. 4,087,702.

IX.

Ormco is a distributor of orthodontic products located in Glendale, California. Ormco Corporation was one of Cablestrand's first customers for its Six Strand wire.

X.

Cablestrand filed its patent application for Six Strand wire on July 5, 1978. The application did not disclose or claim wire with either a lumen or partially separating coils. The application was directed toward the use of five strands overwound about a sixth core strand at a particular range of helical angles.

XI.

On December 6, 1978, in connection with its own application, Cablestrand first became aware of Wallshein's United States Patent No. 4,086,702 upon receipt of an Official Action from the United States Patent Office.

XII.

The Patent Office Examiner's opinion of some claims in Cablestrand's application were initially rejected, citing Wallshein's United States Patent No. 4,086,702.

XIII.

Cablestrand then submitted an argument explaining the distinctions between its Six Strand wire and the wire disclosed in Wallshein's United States Patent No. 4,086,702. Thereafter, on January 8, 1980, Cablestrand's Application was allowed and issued as United States Patent No. 4,182,106.

XIV.

On December 8, 1978, Wallshein filed United States Patent Application No. 967,723, said application being a reissue of United States Patent No. 4,086,702. Application No. 967,723 included dependent claims not included in the original United States Patent No. 4,086,702. On July 17, 1979, the United States Patent Office entered an Official Action allowing the claims of United States Application Serial Number 967,723.

XV.

On December 11, 1979, Wallshein filed a divisional application of his United States Application Serial Number 967,723 as United States Application Serial Number 102,384 to include additional claims directed to the combination of the wire with an orthodontic bracket previously not included in original United States Patent

No. 4,086,702 or United States Application Serial Number 967,723. On December 17, 1980, an Official Action allowing all claims of United States Application Serial Number 102,384 was issued.

XVI.

On July 15, 1980, United States Application Serial Number 967,723 was issued as United States Reissue Patent No. Re. 30,332. On April 28, 1981, United States Application Serial No. 102,384 was issued as United States Reissue Patent No. Re. 30,593.

XVII.

United States Reissue Patent No. Re. 30,593 differs from United States Patent No. Re. 30,332 only to the extent that it claims the combination of an orthodontic bracket with an archwire while only an archwire is claimed in United States Patent No. 30,332.

XVIII.

After receipt of the Notice of Allowance in the first of his reissue patent applications, Wallshein, on June 13, 19, and 24, 1980, telephoned Cablestrand's then president, Stanley Weiss, father of Allan B. Weiss, the defendant, concerning the accused Six Strand wire manufactured by Cablestrand.

XIX.

Approximately two and a half years following the calls in June, 1980, Stanley Weiss suffered a debilitating stroke which left him unable to speak or communicate. Thereafter, in 1983, Allan B. Weiss assumed control of policy decisions for Cablestrand.

XX.

Wallshein took no action against Cablestrand or any person associated with Cablestrand until May, 1984, when Wallshein's attorney sent out letters of accusation of patent infringement to many of Cablestrand's customers. Cablestrand thereafter instituted the declaratory judgment action (CV84-4219-RMT).

XXI.

In 1985, Wallshein filed a counterclaim against Cablestrand (CV84-4219-RMT), alleging infringement of the patents presently in suit before this court. In the counterclaim, Wallshein raises no allegations of culpability against Weiss or any other officer or owner of Cablestrand. Weiss has made numerous personal loans to and investments in Cablestrand to improve the Six Strand wire. The evidence establishes that he would not have done so if the issue of his personal liability was raised at that time.

XXII.

Wallshein first asserted a claim of personal liability against Weiss in August, 1987, in an unsuccessful motion

to join Weiss, as a counterdefendant in CV84-4219-RMT. Then on July 19, 1989, approximately two years later, Wallshein instituted CV89-4329-RMT seeking personal liability against Weiss.

XXIII.

In 1988, Cablestrand filed with the United States Patent and Trademark Office a request for reexamination of the patents in suit, Nos. Re. 30,332 and Re. 30,593 for the purpose of considering prior art that it had not considered previously. The reexamination was conducted by the same Patent Office Examiner who had earlier prosecuted and issued Wallshein's original Patent No. 4,086,702 and both reissue patents in suit.

XXIV.

On December 13, 1988, reexamination certificates confirming the patentability of all the claims in the reissue patents were issued by the Patent Office.

XXV.

Wallshein has accused Cablestrand and Weiss of infringement as it relates to the following claims of Patent No. Re. 30,332: Claims 1, 3, 4, 9 and 52. He has also accused Cablestrand and Weiss of infringement as it relates to the following claims of Patent No. Re. 30,593: Claims 52, 3, 4, 9 and 57.

Any finding of fact which may be deemed a conclusion of law is hereby incorporated into the Conclusions of Law below, and any conclusion of law which may be

deemed a finding of fact is hereby incorporated into the Findings of Fact above.

CONCLUSIONS OF LAW

I.

This court has subject matter jurisdiction. 28 U.S.C. § 1338(a).

II.

Neither Patent No. Re. 30,332 nor Patent No. Re. 30,593 is literally infringed. Such patents include two limitations not present in the Six Strand wire manufactured by Cablestrand. They are: (1) the requirement for a lumen through the archwire, and (2) the requirement of adjacent turns of the wire at least partially separate upon bending.

III.

Lumen. A lumen is a passageway in a tubular organ. The patents describe the lumen as a central opening defined by the turns of wire and is created during the winding of the coils.

In addition, the lumen in the patents in suit allows the characteristics of rigidity, flexibility and springiness (longitudinal) to be adjusted in the wire coil. The lumen diameter can be reduced to almost zero diameter, thus substantially eliminating the lumen lateral flexibility and springiness (longitudinal) are sacrificed to effect more rigidity.

No such alteration or adjustment is possible in the Six Strand wire because the Six Strand wire does not have a lumen. Accordingly, twisting the ends of the Six Strand wire will not reduce the diameter of the coils surrounding the central core wire.

IV.

Partial separation of the wire. The patents in suit require adjacent turns of the wire to at least separate upon bending. The separation is made possible because of the lumen.

There is no separation between adjacent turns in the bent Cablestrand Six Strand wire which would allow food particles to become lodged between the adjacent turns.

The Six Strand wire is not formed of a material sufficiently elastic to permit partial separation between adjacent turns of the archwire by bending the archwire.

V.

Doctrine of Equivalents. The test is: whether "two devices do the same work in substantially the same way, and accomplish substantially the same result." *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950). In interpreting a claim by a patent, reference may be made to specification, prosecution history, and other claims in the patent. *Mannesmann Demag Corporation v. Engineered Metal Products*, 793 F.2d 1279 (Fed.Cir. 1986).

VI.

The Six Strand wire does not have a lumen or passageway, or its equivalent, which allows stiffness of the archwire to be selected by the user by removing or leaving in the mandrel. The accused wire's central core wire is formed as an integral part of the wire. The user cannot select the stiffness.

VII.

Contrary to the patents in suit, the adjacent turns of the archwire of the Six Strand wire does not separate upon bending.

VIII.

35 U.S.C. § 103 provides that a patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

IX.

The patents in suit are not invalid under 35 U.S.C. § 103 (obviousness) nor deemed as combination patents.

X.

Regarding the issue of laches, the principles underlying this doctrine is that it is inequitable to permit a patentee to recover for infringement occurring during the

time of the patentee's own unreasonable, unexcused and harmful delay. *Jackson Jordan, Inc. v. Plasser American Corp.*, 747 F.2d 1567 (Fed.Cir. 1983). Laches begins when a patent owner discovers facts or should have known of defendant's infringing action which creates causes of action. *Coleman v. Corning Glass Works*, 619 F.Supp. 950, 226 USPQ 991 (W.D.N.Y. 1985).

Wallshein knew of defendants' alleged infringing actions in 1978 when he procured from Ormco the Six Strand wire manufactured by Cablestrand. At that time, his duty to make diligent inquiry and to investigate commenced.

Other than telephonically calling Stanley Weiss on three occasions in June, 1980, Wallshein did nothing to assert his rights against Cablestrand until 1985. He did not institute litigation against Weiss until July, 1989.

He has no excuse for this delay.

During this lengthy delay, both Cablestrand and Weiss relied to their detriment on Wallshein's inaction. They became aware of Wallshein's original United States Patent No. 4,086,702, from which the reissue patents in suite [sic] issued, on December 11, 1978. They concluded that their Six Strand wire did not infringe.

They involved themselves in considerable expense in modifying their wire stranding machines. Weiss made substantial investments in Cablestrand during this prolonged period of Wallshein's inactivity.

XI.

Any rights Wallshein may have had against Cablestrand and/or Weiss prior to his institution of the claims in litigation are now barred by the Doctrine of Laches.

XII.

An action was commenced in 1989 against Weiss individually for the activities of infringement wherein Wallshein claims that Cablestrand was merely the alter ego of Weiss.

XIII.

In *Pan Pacific Sash & Door Company v. Greendale Part, Inc.*, 333 P.2d 802 (1958), the court, in discussing "alter ego" liability, required the following showing:

a. "(T)hat the corporation is not only influenced and governed by that person, but that there is such a unity of interest in ownership that the individuality, or separateness, of the said person and corporation has ceased . . . "

b. "(T)hat the facts are such that an adherence to the fiction of the separate existence of the corporation would, under the particular circumstances, sanction a fraud or promote injustice."

Wallshein failed to make the requisite showing which would justify piercing the corporate veil.

Dated: 5/28/93

/s/ Robert M. Takasugi
ROBERT M. TAKASUGI
United States District Judge

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

CABLESTRAND CORPORATION, a California corporation, Plaintiff, vs. MELVIN WALLSHEIN, an individual, Defendant.	No. CV 84-4219-RMT
MELVIN WALLSHEIN, an Individual, Plaintiff, vs. ALLAN B. WEISS, an individual, Defendant.	No. CV 89-4329-RMT(Tx) JUDGMENT (Filed May 28, 1993)

This court having filed its findings of fact and conclusions of law concurrently herewith,

IT IS ORDERED, ADJUDGED AND DECREED as follows:

1. As to the complaint in CV 84-4219, *Cablestrand Corporation v. Melvin Wallshein:* the court has determined, and hereby declares, that (a) the Six Strand wire manufactured and sold by plaintiff Cablestrand Corporation does not infringe defendant Melvin Wallshein's U.S. Patent

Nos. Re. 30,332 and Re. 30,593, or either of them; and (b) defendant Melvin Wallshein's U.S. Patent Nos. Re. 30,332 and Re. 30,593 are unenforceable against the Six Strand wire manufactured and sold by plaintiff Cablestrand Corporation as barred by the Doctrine of Laches.

2. As to the counterclaim in CV 84-4219, *Cablestrand Corporation v. Melvin Wallshein:* counterclaimant Melvin Wallshein shall have and recover nothing.

3. As to the complaint in CV 89-4329, *Melvin Wallshein v. Allan B. Weiss:* plaintiff Melvin Wallshein shall have and recover nothing.

4. Plaintiff and counterdefendant Cablestrand Corporation and defendant Allan B. Weiss shall recover their costs incurred herein.

Dated: 5/28/94

/s/ Robert M. Takasugi
ROBERT M. TAKASUGI
United States District Judge

APPENDIX D

United States Court of Appeals
for the Federal Circuit

ORDER

(Filed July 5, 1994)

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on July 12, 1994.

FOR THE COURT,
FRANCIS X. GINDHART, CLERK

By /s/ Diane M. Frye
Diane M. Frye
Chief Deputy Clerk

Dated: July 5, 1994

cc: MYRON GREENSPAN
CHARLES H. THOMAS

CABLESTRAND CORP V WALLSHEIN, 93-1490
(DCT – 84-4219)

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
717 MADISON PLACE, N.W.
WASHINGTON, D.C. 20439

FRANCIS X. GINDHART
CLERK

TELEPHONE: 633-6550
AREA CODE 202

SEPT. 02, 1992

Charles H. Thomas, Esquire
Cislo & Thomas
4201 Long Beach Blvd.
Suite 405
Long Beach, CA 98097

Myron Greenspan, Esquire
154 Girard Street
Brooklyn, NY 11235

RE: *Cablestrand Corp. v. Wallshein, 92-1418, -1459*

Dear Counsel:

This is in reference to appeal no. 92-1418 and cross-appeal no. 92-1459.

Upon review of the order of the district court, it appears that there may not be a final judgment in this case. Please respond within 10 days. If motions for voluntary dismissal are appropriate, then please promptly file.

Very truly yours,

/s/ Francis X. Gindhart
Francis X. Gindhart

CISLO & THOMAS
Attorneys at Law
4201 Long Beach Boulevard, Suite 405
Long Beach, California 90807

TEL: (310) 595-8422
FAX: (310) 595-9319

DONALD M. CISLO
CHARLES H. THOMAS
A PROFESSIONAL CORPORATION

PATENT, TRADEMARK, COPYRIGHT & UNFAIR COMPETITION CAUSES

September 4, 1992

Mr. Francis X. Gindhart
U.S. Court of Appeals
for the Federal Circuit
717 Madison Place N.W.
Washington D.C. 20239

Re: Cablestrand v. Wallshein
Appeal Nos. 92-1418, -1459

Dear Mr. Gindhart:

Responsive to your letter dated September 2, 1992, the plaintiff-appellant believes that the order entered by the U.S. District Court dated May 29, 1992 is a final, appealable order. Enclosed herewith is a copy of that order as received by counsel for Cablestrand Corporation and Allan B. Weiss. It should be noted that this order bears the legend "THIS CONSTITUTES NOTICE OF ENTRY AS REQUIRED BY FRCP, RULE 77(d)." In the past 16 years during which I have been admitted to and practiced before the U.S. District Court for the Central

District of California, I have never seen the aforesaid notice on any order accept an order of judgment which is immediately appealable.

On or about June 17, 1992, after several attempted telephone communications, I was able to speak by telephone to Judge Takasugi's clerk, Mr. Victor Cruz, whose telephone number is (213) 894-5858. Mr. Cruz advised me that the court did consider the order entered May 29, 1992 to be immediately appealable and that the foregoing legend had been placed on copies of that order sent to counsel to so advise them. It is believed that unless a timely appeal had been filed from the order entered May 29, 1992, Cablestrand Corporation would have been foreclosed from any appeal on the issue of liability in Civil Action No. 84-4219 RMT.

It is noted that although the title of the order of the court entered May 29, 1992 refers to "intended" judgment, the order thereon unequivocally states that defendant Melvin Wallshein takes judgment against Plaintiff Cablestrand Corporation on defendant's counterclaim. Also, the docket entry for that order on page 7 of the district court docket sheet also states that defendant Melvin Wallshein takes judgment against Plaintiff Cablestrand Corporation on defendant's counterclaim.

Rule 36 of the Rules of Appellate Procedure states that the notation of the judgment in the docket constitutes entry of the judgment. That rule also states that the clerk shall, on the date judgment is entered, mail to all parties a copy of the opinion, if any, or of the judgment if no opinion was written, and notice of the date of entry of the judgment. It is believed that the district court order

entered on May 29, 1992 therefore constitutes entry of such judgment.

It is further noted that 28 USC Section 1229(c)(2) provides that the United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction of an appeal from a judgment of a civil action for patent infringement which would otherwise be appealable to the United States Court of Appeals for the Federal Circuit and is final accept for an accounting. It is noted that the only matter left by the court in the order of May 29, 1992 was the matter of addressing the issue of the defendant's remedies.

It is respectfully submitted that the order of May 29, 1992 constitutes an appealable order, and that Cablestrand Corporation would be foreclosed from appealing the issue of liability in Civil Action No. CV 84-4219 RMT had not the present appeal been timely filed.

Respectfully submitted,

/s/ Charles H. Thomas
Charles H. Thomas
Regisration No. 25,710

CHT\vl

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
717 MADISON PLACE, N.W.
WASHINGTON, D.C. 20439

FRANCIS X. GINDHART
CLERK

TELEPHONE: 633-6550
AREA CODE 202

SEPT. 29, 1992

Charles H. Thomas, Esq.
Cislo & Thomas
4201 Long Beach Blvd.
Suite 405
Long Beach, CA 98097

Myron Greenspan, Esq.
154 Girard Street
Brooklyn, NY 11235

RE: *Cablestrand Corp. v. Wallshein, 92-1418, -1459*

Dear Counsel:

This is in response to your submissions dated September 4, 1992 and September 11, 1992 that were requested in the court's September 2, 1992 letter.

We have reviewed both submissions regarding the finality of the judgment. In accordance with Mr. Thomas' statements, it appears that there is a final judgment in this case. Accordingly, the appeal should proceed.

Very Truly yours,

/s/ Francis X. Gindhart
Francis X. Gindhart

FXG:lk

APPENDIX F

Court of Appeals, Federal Circuit

Cablestrand Corp. v. Wallsheim

Nos. 92-1418, -1459

Decided March 8, 1993

Before Smith, senior circuit judge, and Newman and Schall, circuit Judges.

Newman, J.

This patent infringement case reaches this court upon notices of appeal and cross-appeal from the final judgment entered on May 29, 1992 by the United States District Court for the Central District of California following a bench trial. The judgment contains a "general verdict", stating the court's decision in the two consolidated cases as follows:

> The court, after careful and full examination of the evidence relating to liability, has ruled as follows:
>
> 1) That defendant Melvin Wallshein takes judgment against plaintiff Cablestrand Corporation on defendant's counterclaim and that defendant Weiss is awarded judgment on CV89-4329-RMT.

The other paragraph of the judgment relates to the damages phase of the case. The order is stamped "THIS CONSTITUTES NOTICE OF ENTRY AS REQUIRED BY FRCP, RULE 77(d)".

No findings of fact or conclusion of law were filed in accordance with Fed. R. Civ. P. 52(a); none are shown in

the transcript or referred to on the docket sheet. The issues argued on appeal, which include patent validity, infringement, laches, estoppel, and personal liability, are not mentioned. The parts of the record provided in the Appendix show contradictory evidence adduced in four days of trial, on the many fact-dependent issues pressed during the trial.

It may be that the final judgment was entered prematurely, and that the notices of appeal prematurely divested the district court of jurisdiction. Whatever the reason, in this complex case, without findings of fact and conclusions of law, we have no basis on which to review the appealed judgment. *See Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F. 2d 955, 963-64, 1 USPQ2d 1196, 1200-01 (Fed. Cir. 1986) (discussing need for specific findings); *Lindy Pen Co. v. Bic Pen Corp.*, 725 F.2d 1240, 1246, 226 USPQ 17, 21 (9th Cir. 1984), *cert. denied*, 469 U.S. 1188 [226 USPQ 23] (1985) (remanding for finding on specific point in dispute, since district court heard testimony and assessed credibility of witnesses); *Alpha Distributing Co. v. Jack Daniel Distillery*, 454 F.2d 442, 453 (9th Cir. 1972) (factual findings relating to antitrust claims not sufficiently explicit to give a clear understanding of the reasons for the trial court's decision, remanded for supplemental findings), acknowledging *Seligson v. Roth*, 402 F.2d 883, 887 (9th Cir. 1968) (remand not necessary when full understanding of the issues can be reached without full compliance with Rule 52(a); *Irish v. United States*, 225 F.2d 3, 8 (9th Cir. 1955) (findings of fact required).

ACCORDINGLY, IT IS ORDERED THAT:

1. The judgment entered on May 29, 1992 is vacated.

2. The case is remanded for findings of fact and conclusions of law, in accordance with Fed. R. Civ. P. 52(a).

3. The mandate to this effect shall issue forthwith.

APPENDIX G

APPENDIX III

Court's Findings	Source: 4-23-91 Proposed Findings	Subject* Matter
I	pps. 1-2	parties
II	–	jurisdiction
III	p. 2	Identification of Wallshein
IV	p. 2	Identification of CS
V	p. 2	MW's application
VI (sent #1)	pps 2-3	MH's wire
(sent #2)	p. 9, l. 25	no lumen
	p. 10, l. 15-16	no separation
VII	p. 3, l. 4-7	1st manufacture. by CS
VIII	p. 3, l. 9-13	MW's 1st exam of ORMCO wire
IX	p. 3, l. 7-9	ORMCO
X	p. 3, l. 14-20	MH's application
XI	p. 3, l. 21-24	CS's first knowledge of '702
XII	p. 3, l. 24-27	MH's 1st Office Action

---

* CS = Cablestrand; MW = Melvin Wallshein; AW = Allan Weiss; MH = Michael Henry

XIII	p. 3, l. 1 - p. 4, l. 7	MH's prosecution
XIV	p. 4, l. 8-17	MW's reissue
XV	p. 4, l. 18-26	MW's Div. Application
XVI	p. 4, l. 26 - p. 5, l. 3	'332/'593 patent
XVII	p. 5, l. 3-6	Differences in '332/'593
XVIII	p. 5/7-12	1980.tel calls to CS
XIX	p. 5/13-15, 19-21	stroke + AW's control of policy
XX	p. 5/22 - 6/2	no action against CS
XXI	p. 6, l. 3-14	1985 counterclaim; prejudice to AW
XXII	p. 6, l. 15-24	MW's motion + 2nd action
XXIII	p. 7, l. 2-12	Re-examination
XXIV	p. 7, l. 17-20	Re-exam certificates
XXV	p. 8, l. 9-13	asserted claims

APPENDIX IV

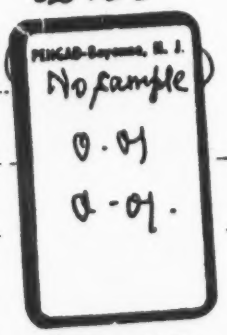
Court's Conclusions	Source: 4-23-91 Proposed Conclusions	Subject Matter
I	p. 8, l. 2-3	jurisdiction
II	8/15-21; 10/6-8	2 absent claim limitations
III	8/21 - 9/24	no lumen
IV	10/6 - 11/16	no separation
V (1st sent.)	13/19-23	Test of doct. of Equiv.
(2nd sent.)	14/2-6	Interpretation of claims
VI	15/11-18	no lumen/integral w/core
VII	15/14-15	no separation
VIII	16/24 - 17/5	defines § 103
IX	–	NOT INVALID
X (1st par.)	–	policy behind laches
(2nd par.)	27/8-12	knowledge of ORMCO
(3rd par.)	27/13-28/5	nothing to assert rights > phone calls

(4th + 5th pars)	28/6-21	reliance/detriment
XI	–	barred by laches
XII & XIII	29/16-30/7	no alter ego

Gap Measurements From SEMicrographs. (200x pictures)

CABLE STRAND. (Bent samples)

Mandrel Size	Wire size. (in inches) 0.0155"	0.0175"	0.0195"
Ex #'s, 361, 367, 364, 375, 378 ⇐ 381, 557, 559.	½"	0.0145 mm	0.015 mm
	¼"	0.019 mm	0.0175 mm
	⅛"	0.0275 mm	0.0225 mm



→ CABLE STRAND (STRAIGHT LENGTH)

(0.0175" dia) 0.0075 mm → Exhibit # (384, ~~386~~)

EXPRESS DENTAL. (Bent samples)

Mandrel Size	Wire size (in inches) 0.0155"	0.0175"	0.0195"
Ex 506, 509, 512, 519, 522, 525, 532, 535, 538.	½" →	0.0075 mm	0.01 mm	0.0185 mm
	¼" →	0.01 mm	0.0115 mm	0.0305 mm
	⅛" →	0.0125 mm	0.017 mm	0.0600 mm

EXPRESS DENTAL (STRAIGHT LENGTH)

Ex 516, ~~531~~	0.0155" dia	0.0175" dia	0.0195" dia.
Gap size →	0.005 mm	0.00125 mm	0.001 mm.

Gap measurements form Cross section → Bent + ~~taped~~ Coated + Acrylic mount

Express dental – 0.0195" dia ; ¼" mandrel

Gap size: ~~0.0125~~ 0.0125" (Ex 933) → Compare w

0.0155" dia ; ¼" mandrel

Gap size: 0.03 mm (Ex 937) → Compare

APPENDIX I

TESTIMONY OF DR. RAYMOND C. THUROW

(April 30, 1991)

[p. 56] MR. GREENSPAN: YOUR HONOR, COULD I JUST MAKE ONE REQUEST?

THE COURT: YES.

MR. GREENSPAN: DOCTOR THUROW HAD REMOVED THE ENDS OFF OF THE PIECE OF CABLESTRAND WIRE.

[p. 57] JUST SO THAT WE'RE NOT ACCUSED LATER OF HAVING CHANGED WIRES, AND DOCTOR – AND MR. THOMAS HAS QUESTIONED HIM ABOUT HIS PROCEDURE, CAN DOCTOR THUROW JUST PULL THAT WIRE OUT WHILE HE'S ON THE STAND SO WE CAN GET IT OUT OF THE WAY?

THE COURT: YES.

MR. GREENSPAN: THANK YOU.

MR. THOMAS: WELL, WE'D LIKE – WOULD YOU EXPLAIN EXACTLY WHAT YOU HAVE DONE TO THAT OR –

THE WITNESS: I HAVE UNWOUND THE ENDS AS YOU DID, ONLY VERY EVENLY SO THAT THEY'RE ALL EVEN.

THE ONE THAT YOU HAD UNWOUND – ONE WAS UNWOUND TWO TURNS DOWN BEYOND SOME OF THE OTHERS. IF YOU PRESS ON THAT, IT'S GOING TO PUSH SIDEWAYS, AND IT'S GOING TO LOCK ON –

AT LEAST RUN A GREAT RISK OF LOCKING ON THE CORE.

SO I MERELY EVENLY UNWOUND THEM, AND I DID START TO PULL IT.

I HAVE TO GET A GRIP ON THIS, HAVE TO FIND A PLACE.

MR. GREENSPAN: DO YOU WANT TO COME UP AND LOOK?

THIS IS THE HIGHLIGHT OF THE AFTERNOON, JUDGE. YOU MIGHT NOT WANT TO MISS THIS.

THE WITNESS: I WILL TRY IT WITH MY THUMB RIGHT HERE.

/ [p. 58] (OFF-THE-RECORD)

MR. THOMAS: WHAT – THE THING THAT IS – WELL, WE WILL HAVE MORE TESTIMONY TOMORROW.

THE COURT: ALL RIGHT, THANK YOU.

MR. GREENSPAN: THANK YOU, YOUR HONOR.

MR. THOMAS: THANK YOU, YOUR HONOR.

CROSS-EXAMINATION

(May 1, 1991)

[p. 4] BY MR. THOMAS:

Q. DR. THUROW, HOW LONG DID YOU SPEND WORKING ON THAT PIECE OF WIRE YESTERDAY TO PREPARE IT FOR YOUR DEMONSTRATION?

A. I GUESS IT WAS APPROXIMATELY FIFTEEN MINUTES. I DID IT BACK AT THAT CHAIR BEHIND YOUR TABLE.

Q. FIFTEEN MINUTES TOTAL?

A. THAT'S A REASONABLE APPROXIMATION, I WOULD SAY. YES.

Q. IS THE REMOVAL OF THE CORE WIRE FROM THE CABLESTRAND WIRE A PRACTICAL OPTION FOR AN ORTHODONTIST?

A. A PRACTICAL OPTION FOR THE ORTHODONTIST ON A DAILY [p. 5] BASIS, PERHAPS. I INTEND TO PLAY WITH THEM IN THAT WAY MYSELF.

HOWEVER, IF THAT SHOULD PROVE USEFUL TO A MARKETABLE DEGREE, THEN THE MANUFACTURERS COULD CERTAINLY DEVISE VERY EFFICIENT WAYS OF REMOVING THOSE. IT'S A CRUDE OPERATION, THE WAY I DID IT, USING AVAILABLE INSTRUMENTS, NO SPECIALIZED TOOLS AT ALL.

IT COULD BE MECHANIZED VERY EFFICIENTLY IF THERE WERE AN INDICATION TO DO SO.

Q. YOU SAY IF IT WERE TO PROVE USEFUL. IS IT USEFUL, IS THERE ANY REASON FOR REMOVING THE CORE WIRE FROM THE CABLESTRAND WIRE?

A. THE CABLESTRAND WIRE, WHEN IT TAKES A PERMANENT SET, THE PERMANENT SET IS IN THE CORE, AT LEAST IT'S IN THE CORE FOR THE FIRST – LONG BEFORE IT IS FOR THE COILS, SO THAT WITH RELATIVELY MODERATE BEND, IT SHOULD BE POSSIBLE ACTUALLY TO EXTRACT THE CORE AND HAVE THAT THING STRAIGHTENED OUT AGAIN.

SO THE ELASTIC RANGE OF THE WIRE WOULD BE EXTENDED. THE FORCE WOULD BE REDUCED SIGNIFICANTLY BECAUSE CABLESTRAND USES A CORE THAT'S LARGE ENOUGH THAT IT CONTRIBUTES A MAJOR FORCE COMPONENT AS WELL.

SO YOU WOULD BE REDUCING FORCE LEVELS RATHER MARKEDLY BY REMOVING THE CORE. THESE ARE ALL MATTERS OF INDIVIDUAL APPLICATION.

[p. 6] NONE OF THESE – THERE IS NO ORTHODONTIC WIRE THAT'S UNIVERSALLY APPLICABLE FOR EVERY PATIENT, SO THEY HAVE TO BE SELECTED. THIS IS AN OPTION THAT EXTENDS THE RANGE THAT I THINK MIGHT BE WORTHY OF EXPLORATION, BUT I ONLY BECAME AWARE OF THIS POSSIBILITY OR GAVE IT ANY THOUGHT WITHIN THE LAST FEW WEEKS AND HAVE NOT APPLIED THEM CLINICALLY.

I KNOW THEY WILL WORK IN CERTAIN SITUATIONS AND I INTEND TO HAVE ONE ON HAND SHOULD SUCH AN OCCASION ARISE.

Q. WITH THIS 15 MINUTES – IF AN ORTHODONTIST WERE TO DO WHAT YOU DID YESTERDAY IN HIS OFFICE, THE 15 MINUTES, THE PATIENT WOULD BE SITTING IN THE CHAIR; IS THAT CORRECT?

A. HEAVENS, NO. YOU CAN DO THESE OVER THE WEEKEND, YOU CAN HAVE YOUR ASSISTANTS DO IT.

LAST NIGHT I DID A UNITEK WIRE IN JUST A FEW MINUTES. I WAS EXTRA CAREFUL HERE BECAUSE IF MURPHY'S LAW IS EVER GOING TO COME IN, IT'S WHEN YOU ARE SITTING IN FRONT OF THE JUDGE TRYING TO TAKE THIS WIRE OUT.

SO BELIEVE ME, I GAVE IT EXTRA CARE SO THAT IF IT DIDN'T COME OUT. I DIDN'T HAVE TO BE FUMBLING AROUND TRYING TO DO MORE. BUT LAST NIGHT, I TOOK A 14-INCH LENGTH OF UNITEK 15.5 AND IN CERTAINLY FAR LESS THAN FIVE MINUTES, PREPARED ONLY ABOUT 3/8THS OF AN INCH OF THE ENDS SO I COULD GET A GRIP, PULLED IT OUT A LITTLE BIT, ABOUT AN INCH AND A HALF. I GRASPED THE OTHER END OF THE PLIER WHERE THERE WAS [p. 7] NO CORE TO SEE IF I COULD PULL IT OUT AS WE WERE TALKING ABOUT YESTERDAY.

IT PULLED THE TURNS ALL APART, DID NOT SEPARATE. I WENT BACK TO THE TOP END AND PUSHED THE REST OF IT OUT AS I DID HERE. IT

COULD BE SPEEDED UP MARKEDLY IF THERE WERE ANY REASONS TO DO IT, EVEN IN THE OFFICE.

BUT ORTHODONTISTS WORK WITH WIRES FROM A DRAWER AND YOU CAN PUT THESE IN THE DRAWER ANY TIME YOU PLEASE.

MR. THOMAS: I HAVE NO FURTHER QUESTIONS.

THE COURT: ANY REDIRECT?

MR. GREENSPAN: NO, YOUR HONOR. I WOULD LIKE TO JUST INTRODUCE THAT EXHIBIT INTO EVIDENCE.

THE COURT: VERY WELL.

YOU MAY STEP DOWN.

DID THAT COME IN UNDER STIPULATION?

THE WITNESS: YOUR HONOR, WITH YOUR PERMISSION, I AM NOT SURE WHAT WENT INTO THE RECORD ON THE REMOVAL OF THAT WIRE YESTERDAY AFTERNOON.

COULD I MAKE A BRIEF STATEMENT OF WHAT I DID TO BE SURE THAT THAT IS IN THE RECORD?

THE COURT: THERE IS NO QUESTION PENDING.

THE WITNESS: IT'S ADEQUATELY COVERED. OKAY.

TESTIMONY OF DR. LARRY E. McNIGHT

(May 2, 1991)

CROSS-EXAMINATION

* * *

[p. 99] Q IF IT TURNED OUT THAT THE CORE OF THE CABLESTRAND WIRE COULD BE EASILY REMOVED, WOULD YOUR OPINION CHANGE ON THIS QUESTION OF CABLESTRAND'S STRANDS BEING TIGHTLY WOUND AROUND THE CORE?

A WELL, IF IT COULD BE EASILY REMOVED, THEN THAT WOULD IMPLY THAT THERE IS LESS TENSION OR THERE'S MINIMAL TENSION BETWEEN THE TWO IF IT SLIDES OUT EASILY.

* * *

[p. 104] Q AND IF A DIFFERENT TECHNIQUE WERE TO BE DEVISED, WHICH WAS A VALID WAY OF REMOVING THE CORE IN A LONGER LENGTH, WOULD THE CABLESTRAND WIRE THEN ALSO FALL INTO THE CONFINES OF THIS EXHIBIT 1*?

A IF ANOTHER TECHNIQUE COULD EASILY BE USED, I WOULD ASSUME, YES.

MR. GREENSPAN: I HAVE NO FURTHER QUESTIONS.

---

* U.S. Patent No. Re. 30,332.

Supreme Court, U.S.
FILED
JAN 3 1995
OFFICE OF THE CLERK

No. 94-811

In The

Supreme Court of the United States

October Term, 1994

MELVIN WALLSHEIN,

Petitioner,

v.

CABLESTRAND CORPORATION

and

ALLAN B. WEISS,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

CHARLES H. THOMAS
CISLO & THOMAS
4201 Long Beach Boulevard
Suite 405
Long Beach, California 90807
(310) 595-8422

Counsel for Respondents Cablestrand Corporation and Allan B. Weiss

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTIONS PRESENTED

The questions presented in the petition are argumentative, replete with misstatements of fact and law, and repetitious. The only question which could have been stated is:

1. Did the Court of Appeals, by affirming the District Court's determination of failure of Petitioner to carry the burden of proving infringement of his patents, so far depart from the accepted and usual course of judicial proceedings, or sanction such a departure by the District Court, as to call for an exercise of the Supreme Court's power of supervision?

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

STATEMENT OF THE CASE 1

SUMMARY OF THE ARGUMENT 3

ARGUMENT 4

PETITIONER'S ATTACK UPON THE CAFC DECISION OF MARCH 8, 1993 IS UNTIMELY 4

THE DISTRICT COURT PROPERLY CONSIDERED THE EVIDENCE WITH RESPECT TO ALL ISSUES AND ENTERED FINDINGS IN ACCORDANCE WITH THE FEDERAL RULES OF CIVIL PROCEDURE 6

The District Court Correctly Found, Based on the Evidence, That There Was No Infringement 6

The Finding That the Accused Wire Does Not Have a "Lumen" Is Not Clearly Erroneous 12

THE ALLEGATIONS OF THE EXISTENCE OF PURPORTED "BIASES" BY THE DISTRICT COURT WERE NOT TIMELY RAISED IN THE APPEAL BELOW 15

THE ALLEGATIONS OF DENIAL OF DUE PROCESS BY THE DISTRICT COURT ARE SPECIOUS AND REPLETE WITH FALSE REPRESENTATIONS 15

THE ALLEGED "BIASES" ATTRIBUTED TO BOTH THE DISTRICT AND APPELLATE COURTS ARE TOTAL FABRICATION 23

CONCLUSION 24

TABLE OF AUTHORITIES

Page

CASES

Allen Bradley Co. v. Local Union No. 3, I.B.E.W., 145 F. 2d 215 (CA 2 1944), reversed on other grounds 325 U.S. 797, 65 S. Ct. 1533 23

Black Diamond Coal Co. v. Excelsior Coal Co., 156 U.S. 611, 39 L. Ed. 553 (1895) 8

Brown Paper Mill Co., Inc. v. Irwin, 134 F. 2d 337 (CA 8 1943) 23

Dunbar v. Meyers, 94 U.S. 399, 49 L. Ed. 110, 25 S. Ct. 697 7

FCC v. League of Women Voters of California et al, 468 U.S. 364, 82 L. Ed. 2d 278 4

Federal Trade Commission v. Minneapolis – Honeywell – Regulator Co., 344 U.S. 206, 73 S. Ct. 245, 97 L. Ed. 2455 (1952) 4

Gaddis v. Calgon Corp., 506 F. 2d 880, 184 USPQ 449 (CA 5) 7

General Talking Pictures Corp. v. Western Elec. Co., 304 U.S. 175, 58 S. Ct. 849, 82 L. Ed. 1273 (1938) 10

Johnson v. IVAC Corp., 885 F. 2d 1574, 12 USPQ 2d 1382 (CAFC 1989) 8

National Labor Relations Bd. v. Pittsburgh Steamship Co., 340 U.S. 498, 71 S. Ct. 453, 95 L. Ed. 479 (1951) 10

Peterson, Lighterage & Towing Corp. v. New York Central R. Co., 126 F. 2d 992 (CA 2 1942) 23

Prouty v. Ruggles, 41 U.S. 336, 10 L. Ed. 985 (1842) 8

TABLE OF AUTHORITIES – Continued

Page

Rice v. Sioux City Memorial Parks Cemetery, 349 U.S. 70, 75 S. Ct. 614, 99 L. Ed. 897 (1955) 11

Texas Instruments, Inc. v. United States International Trade Commission, 988 F. 2d 1165, 26 USPQ 2d 1018 (1993) 9

Unique Concepts, Inc. v. Brown, 939 F. 2d 1558, 19 USPQ 2d 1500 (1991) 9

United States v. Forness, 125 F. 2d 928 (CA 2 1942) cert. den. 316 U.S. 694, 62 S. Ct. 1293, 86 L. Ed. 1764 23

Young v. Murphy, 9 Fed Rules Serv. 52a.11, Case 2, 1946 23

FEDERAL RULES

Rules of the Supreme Court of the United States

Rule 10 S. Ct. 10

Rule 13 S. Ct. 4

Rules of the Court of Appeals for the Federal Circuit

Rule 28 CAFC 2

Federal Rules of Civil Procedure

Rule 52 FRCP 1, 17, 22

Rule 59 FRCP 18, 19

Rule 60 FRCP 19

TABLE OF AUTHORITIES – Continued

Page

LOCAL RULES OF THE U.S. DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Rule 9.5 USDC CD CA 20

Rule 13.6 USDC CD CA 2

STATEMENT OF THE CASE

Petitioner alleges that there was such a deviation from the Federal Rules of Civil Procedure by the District Court that he was denied due process. Yet Petitioner fails to relate specifically how the actions of the District Court of which he complains violated any passage of the Federal Rules of Civil Procedure. Petitioner further alleges that the Court of Appeals for the Federal Circuit (CAFC) denied him due process by applying the "clearly erroneous" standard to the findings of the District Court and that this was somehow contrary to the Federal Rules of Civil Procedure. He makes this assertion despite the fact that Rule 52(a) of the Federal Rules of Civil Procedure specifically states that findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. Moreover, Petitioner ignores the fact that the CAFC based its affirmation of the District Court on its own interpretation de novo of the critical claim limitation of "partially separating turns."

The Petition for Writ of Certiorari totally ignores the great weight of evidence against Petitioner that was presented at trial in the District Court and which was reproduced in the Appendix on appeal and referred to extensively in the briefs submitted on appeal to the CAFC. It is therefore appropriate to refer specifically herein to matters in evidence and statements in the proceedings as reproduced in the Appendix and considered by the CAFC in reaching its judgment of May 24, 1994.

References to specific pages of the CAFC Appendix are in the form: (Apx.___). References to the Trial Transcript specify the separate volumes of the transcript taken in chronological order at trial as Volumes I, I', II, III and IV. References to pages and line numbers are to the numbered pages and lines within the volume cited. These references to the Trial Record are in the following form: (T. R. Vol. ___, p. ___, l. ___, Apx. ___). Also, since the trial was a bench trial the direct testimony of each party's case in chief was presented in the form of a narrative declaration in accordance with Rule 13.6 of the Local Rules of the U.S. District Court for the Central District of California. References to pages and lines of this narrative testimony is in the form of (Narr. ___, p.___, l.___, Apx.___). In addition to the Appendix page designations required by CAFC Rule 28(e), references to Exhibits include the trial exhibit numbers and are in the following form: (Exh. ___, Apx. ___).

The critical issues which were before the District Court for trial were:

1. Whether or not Cablestrand's wire infringed the patents in suit;

2. Whether or not the patents in suit were valid;

3. Whether or not Wallshein was barred by either laches or estoppel in his claims against Cablestrand;

4. Whether or not Allan B. Weiss had any personal liability in connection with the manufacture of the wire; and

5. Whether or not Wallshein was barred by either laches or estoppel from recovery against Weiss personally.

SUMMARY OF THE ARGUMENT

This petition is untimely with respect to any alleged denial of due process for vacation of the District Court order of May 29, 1992, since Petitioner failed to timely file a Petition for Certiorari when the Appellate Court vacated that judgment on March 8, 1993.

Petitioner's allegations of a denial of due process are sheer fabrication. The plain truth is that Petitioner received full and fair consideration of his allegations in the courts below. The Petition for Certiorari in this case is filled with outrageous misstatements of fact and unsupported allegations of fictitious "biases" which purportedly lead to a denial of due process in the litigation below. Petitioner offers no facts, but only unsupported allegations as to the existence of "complex subject matter" and "heavy docket" biases. Petitioner's argument totally ignores the fact that the evidence considered by the District Court weighed heavily against him. Neither the District Court nor the CAFC violated the Federal Rules of Civil Procedure. Petitioner simply failed to carry his burden of proof, but is now dissatisfied with the result.

ARGUMENT

PETITIONER'S ATTACK UPON THE CAFC DECISION OF MARCH 8, 1993 IS UNTIMELY

In his petition Petitioner attacked the portion of the CAFC decision of March 8, 1993, which vacated the judgment of the District Court entered on May 29, 1992 (Petition, pages 16-17). Rule 13 of the Rules of the Supreme Court provides that a petition for Writ of Certiorari to review a judgment of a United Stated Court of Appeals must be filed within ninety days after the entry of the judgment.

The period within which an appeal must be taken of a Petition for Certiorari filed begins to run anew only when the lower Court changes matters of substance or resolves a genuine ambiguity in a judgment previously rendered and not when a judgment previously entered has been reentered or revised in an immaterial way; *FCC v. League of Women Voters of California et al.*, 468 U.S. 364 at 373, 82 L. Ed. 2d 278; *Federal Trade Commission v. Minneapolis - Honeywell - Regulator Co.*, 344 U.S. 206, 73 S. Ct. 245, 97 L. Ed. 2455 (1952). Here there was no revision whatsoever of the first CAFC judgment of March 8, 1993 in the second CAFC judgment of May 24, 1994. Petitioner's petition for a review of the CAFC decision of March 8, 1993, comes more than a year and a half after that decision was entered, and is woefully untimely as to that decision.

At page 17 of his Petition Petitioner argues that the action of the CAFC in vacating the District Court Order of May 29, 1992, was *ultra vires*. This assertion now directly contradicts his own prior statements made in his

own appeal brief in his cross appeal of that District Court Order. In that brief Petitioner stated:

> "The statutory basis for jurisdiction of this Court to hear the appeal and cross appeal is 28 USC Section 1291 and 28 USC Section 1295(a)(1).
>
> The present appeal is timely, having been filed within 30 days of the date of the decision of the U.S. District Court entered on May 29, 1992, as required by Federal Rule of Appellate Procedure 4(a)(1). The present appeal is from a final order or a final judgment that disposes of all claims of liability with respect to all parties in both Civil Action No. CV 84-4219 and Civil Action No. CV 89-4329."

Petitioner then went on to request that the Lower Court be affirmed in Action I and reversed in Action II.

Petitioner now approaches this court with the disingenuous argument that the action of the CAFC in vacating the order, which he had acknowledged as being final and appealable and in which he requested partial affirmation, was *ultra vires*.

In footnote 9 of the Petition Petitioner asserts that the CAFC decision to vacate the District Court's holding of its intent to find for Petitioner was "contrary to the law." Petitioner provides no illumination as to "the law" to which he refers. However, this point is moot since Petitioner's petition is untimely as to the CAFC judgment of March 8, 1993.

THE DISTRICT COURT PROPERLY CONSIDERED THE EVIDENCE WITH RESPECT TO ALL ISSUES AND ENTERED FINDINGS IN ACCORDANCE WITH THE FEDERAL RULES OF CIVIL PROCEDURE

The District Court Correctly Found, Based on the Evidence, That There Was No Infringement

The accused wire does not have "partially separating turns" as required by the patent claims. The claims of Petitioner's patents require coiled strands made from a material sufficiently elastic to permit bending of the archwire by selectively and at least partially separating adjacent turns. Fig. 5 of both patents illustrates the degree of separation contemplated. With reference to Fig. 5 of the reissue patent drawings (Exh. 1, Apx. 81) it can be seen that where the archwire 10 is bent there is a significant partial separation between the adjacent turns of the helically wound filaments 11, 12 and 13. It is possible for this separation to occur because at the center of the wire coils there is a lumen. As a result there is little friction between the central core wire, if one is utilized, and the overwound filaments which would prevent the longitudinal separation of adjacent turns.

The patents discuss the creation of a separation between turns sufficiently large so that the protection of tissues in the mouth and the prevention of food particles from entering into the spaces in the wire are of concern (Exh. 1, col. 4, l. 54-59, Apx. 74). The patents discuss this extent of separation as being on the order of the thickness of the fastening wires 36 (Exh. 1, col. 6, l. 62-68, Apx. 75), which is on the order of .009 to .010 inches (Narr. Dr. Garth Reid, p. 7, l. 23-27, Apx. 14).

The patents state that the localized separation of originally abutting turns, as depicted in Fig. 5, allows the wire to bend significantly without permanently being deformed and without loss of resiliency when mounted in orthodontic brackets (Exh. 1, col. 5, l. 64 - col. 6, l. 11, Apx. 75).

Even when the accused wire is flexed to the extent that it acquires a permanent deformation, there is no separation of turns which is visible to the naked eye, and no separation of turns which has any clinical significance to an orthodontist (Narr. Dr. Garth Reid, p. 8, l. 13-20 and p. 14, l. 7-25, Apx. 15 and 17). There is no separation of adjacent turns in the bent wire manufactured by the Respondent Cablestrand which would allow food particles to become trapped between the adjacent turns, as contemplated in Petitioner's patents (Exh. 1 at col. 4, l. 55-59, Apx. 74). Likewise, there is no partial separation which would even approach the thickness of the fastening wires that hold the archwire onto the bracket, as described in the patents (Exh. 1, col. 6, l. 62-68, Apx. 75).

No contrary evidence at trial was presented. Instead, Petitioner attempted to show through photographs taken with an electron microscope that the adjacent helically overwound strands of the accused wire had "at least partially separating adjacent turns".

It is a fundamental axiom of patent law that an omission in the accused device of an ingredient or element contained in the complainant's patent avoids an infringement; *Dunbar v. Meyers*, 94 U.S. 399, 49 L. Ed. 110, 25 S. Ct. 697; and *Gaddis v. Calgon Corp.*, 506 F. 2d 880, 184 USPQ 449 (CA 5). Omission of even one element or

ingredient of a combination covered by any claim of a patent avoids any charge of infringement based upon that claim, *Prouty v. Ruggles*, 41 U.S. 336, 10 L. Ed. 985 (1842); *Black Diamond Coal Co. v. Excelsior Coal Co.*, 156 U.S. 611, 39 L. Ed. 553 (1895).

The District Court properly held in its Findings of Fact and Conclusion of Law that the accused wire did not meet the claim requirement for partial separation of turns (Finding of Fact VI and Conclusion of Law IV).

In its prior decision in *Johnson v. IVAC Corp.*, 885 F. 2d 1574, 12 USPQ 2d 1382 (CAFC 1989) the CAFC had previously rejected a contention by a patentee that evidence of microscopic structural features could create literal infringement where those microscopic features played no part in the function of the accused device. In this litigation the CAFC specifically addressed the separating turns limitation and the findings of the District Court that the Respondent Cablestrand's wire did not meet that limitation.

Petitioner falsely alleges that "the CAFC proceeded to "dispose" of the appeal on a totally new theory which was conceived by the CAFC but had no basis whatsoever in the trial record" (Petition, page 26). In fact the CAFC specifically held that it was reviewing the construction given the claims *de novo*. The CAFC correctly observed that Petitioner's proposed claim construction was that the phrase "at least partially separating" included any degree of separation, no matter how small or microscopic. The CAFC disagreed with Petitioner and quite accurately held that Petitioner's proposed claim construction would render meaningless this express limitation in the claims.

Petitioner's argument that the strands of the Respondent Cablestrand's wire will separate (when bent sufficiently to inelastically deform) is a characteristic of all prior art stranded wire. It was a blatant misrepresentation for Petitioner to state at trial that what he illustrated in Fig. 5 and discussed extensively throughout his patents, and which appears as the penultimate limitation of his claims was intended to merely state a physical characteristic of all prior art coaxial stranded wire (e.g., Exh. 420, p. 183, Apx. 173).

The CAFC followed its own precedents in *Unique Concepts, Inc. v. Brown*, 939 F. 2d 1558, 19 USPQ 2d 1500 (1991) and *Texas Instruments, Inc. v. United States International Trade Commission*, 988 F. 2d 1165, 26 USPQ 2d 1018 (1993) in which it had rejected a patentee's proffered claim construction because it would render the disputed claim language mere surplusage. The CAFC therefore correctly construed the claims as requiring the amount of separation between adjacent turns upon bending of the arch wire to be of a magnitude somewhat greater than microscopic. The CAFC properly held, based upon its own precedents, that all of the limitations of the claim must be considered meaningful. It properly rejected Petitioner's argument (adopted for purposes of trial) that the phrase "at least partially separating turns" was merely a truism describing a phenomenon dictated by the laws of physics and which occurs in every prior art wire and that this phrase should be treated as mere surplusage. The CAFC properly concluded that the separations between adjacent turns must be of some magnitude greater than microscopic.

The holding of an absence of "at least partially separating turns" was dispositive of the issue of infringement, and indeed of the entire case. The CAFC stated that, during oral argument before it, Petitioner's counsel had agreed that an affirmation on the issue of non-infringement would render moot the issues of laches and the Respondent Weiss' personal liability.

An issue of fact is not "important" for purposes of considering a Grant of Certiorari under U.S. Supreme Court Rule 10. Normally, the United States Supreme Court will not grant certiorari to review a decision that turns solely upon an analysis of facts, or to determine whether the evidence supports a judgment of a district court or an administrative agency. As to such issues, the courts of appeals are generally the courts of last resort. As held in *National Labor Relations Bd. v. Pittsburgh Steamship Co.*, 340 U.S. 498, 71 S. Ct. 453, 95 L. Ed. 479 (1951):

> "This is not the place to review a conflict of evidence nor to reverse a Court of Appeals because were we in its place we would find the record tilting one way rather than the other, though fair-minded judges could find it tilting either way. It is not for us to invite review by this Court of decisions turning solely on evaluation of testimony where on a conscientious consideration of the entire record a Court of Appeals under the new dispensation finds the Board's order unsubstantiated."

Likewise, this Court has held in *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U.S. 175, 58 S. Ct. 849, 82 L. Ed. 1273 (1938) that granting of a Writ of Certiorari

would not be warranted merely to review the evidence or inferences drawn from it.

Furthermore, this Court held in *Rice v. Sioux City Memorial Parks Cemetery*, 349 U.S. 70, 75 S. Ct. 614, 99 L. Ed. 897 (1955):

> "A writ of certiorari will not be granted by the Supreme Court except in cases involving principles the settlement of which is important to the public, as distinguished from that of the parties . . . "

The CAFC did indeed find that the determination by the District Court with respect to the issue of "partially separating turns" was dispositive of the entire litigation, since without that claim element there could be no infringement by any party. Thus, even if the District Court had limited its findings to only that issue, its judgment would properly have been upheld. If there had been any "heavy docket bias" or "complex issues bias" as Petitioner alleges, the District Court would surely have gone no further in its findings. Quite to the contrary, however, the District Court fully considered each and every one of the critical issues in this litigation, previously enumerated herein, and entered findings of fact and conclusions of law with respect to all of them.

Petitioner falsely alleges that the District Court did not independently evaluate the evidence or render its judgment on the evidence. These allegations are without any support in the record and are totally untrue.

The Finding That the Accused Wire Does Not Have a "Lumen" Is Not Clearly Erroneous

Another claim feature which is absent from the accused wire is a plurality of coiled strands wound in the form of a coiled wire having a lumen extending therethrough. In the patents in suit the term "lumen" is repeatedly referred to as a "passage" 18 within which a mandrel 60 may or may not be left subsequent to manufacture (Exh. 1, col. 3, l. 57-66, and col. 4, l. 18-22, Apx. 74). In his patents Petitioner stated that the feature of being able to leave the mandrel 60 inside the archwire or, at the option of the user, remove it prior to use allowed one to affect the characteristics of the wire (Exh. 1, col. 7, l. 59 - col. 8, l. 3, Apx. 76). The patents state that "where most of the work involves bends in small spaces, the mandrel 60 is advantageously removed so as to increase the working range of the archwire" (Exh 1, col. 7, l. 68 to col. 8, l. 3, Apx. 76).

At trial Petitioner sought to broaden the scope of his claims by redefining the term "lumen". His new definitions were especially created for purposes of trial and appear nowhere in the patents in suit nor in the prior art. The District Court properly found Petitioner's evidence that the accused wire met this claim limitation to be unconvincing. The District Court, in its findings of fact and conclusions of law, defined the term "lumen" as utilized in the patents in suit and held that the accused wire does not have a lumen (Conclusions of Law III).

The patents also state that the ability to remove the mandrel allows one to alter the characteristics of flexibility, springiness, and rigidity by selectively twisting

the ends of the wire in opposite directions (with the mandrel removed) to reduce the diameter of the lumen as desired by the user (Exh. 1, col. 8, l. 21-42, Apx. 76). The lumen diameter can be reduced to a substantially zero diameter (Exh. 1, col. 9, l. 17-22, Apx. 77). By substantially eliminating the lumen lateral flexibility and longitudinal springiness are sacrificed in favor of more rigidity (Exh. 1, col. 8, l. 39-42, Apx. 76).

At trial numerous samples of promotional material used by distributors of the Respondent Cablestrand's orthodontic archwire were presented (Exhs. 768-799 and 900-927, Apx. 516-525, 707-778, and 1650-1706). Nowhere in any of this promotional material was there any claim of a capability of removal of a center core strand from the surrounding overwound strands.

Petitioner argues at page 24 of his petition that the accused wire infringed because his witness, Dr. Thurow, in court was able to "effortlessly" withdraw the core wire from the accused wire. However, it is uncontroverted that Dr. Thurow spent approximately fifteen minutes of time manipulating and partially unraveling the strands of a short section of the accused wire in order to be able to accomplish this "effortless" task (T.R. Vol. II, p. 4, l. 17-22, Apx. 55). On cross examination Dr. Thurow testified, when asked if there was any reason for removing the Cablestrand wire, that he had only become aware of the possibility within the last few weeks and had not applied it clinically (Appendix to Petition for Certiorari, page 44a).

Petitioner hypocritically chastises the District Court for not explaining why the courtroom demonstration of

Dr. Thurow was given little or no weight and for not commenting in its findings on this test. However, although Petitioner now claims that Dr. Thurow's mastery of this manipulation of the wire strands was exceedingly important, he did not consider it at all important at the trial. Quite to the contrary, at trial when Petitioner himself was unable to extract the core wire from the surrounding strands of the accused wire Petitioner's counsel stated:

> "However, I just want to make it very clear, your honor, that this test and this whole concept of withdrawing the core from the strand is totally, totally irrelevant to the patent." (T.R. vol. I', p. 5, l. 18-21, Apx. 51B).

Petitioner also alleges in his Petition that the District Court ignored purported "critical facts" that required a finding of infringement. Petitioner's statements are both false and misleading. In his brief he attributed to one of Plaintiff's expert witnesses, Dr. Larry McKnight, a statement that certain test results submitted to the District Court were false. This is absolutely untrue. Furthermore, at page 23 of his Petition Petitioner does not even quote Dr. McKnight, but rather again attributes to him statements that he never made.

Furthermore, whether or not the accused wire had a lumen is inconsequential, since infringement could not be found because the accused wire did not meet the "partially separating turns" claim limitations. Neither the testimony of Dr. McKnight to which Petitioner refers, nor

the courtroom demonstration of Dr. Thurow had anything whatsoever to do with the findings regarding partially separating strands, which was totally dispositive of the entire case.

THE ALLEGATIONS OF THE EXISTENCE OF PURPORTED "BIASES" BY THE DISTRICT COURT WERE NOT TIMELY RAISED IN THE APPEAL BELOW

On certiorari to review a decision of a Federal Court of Appeals which affirmed a District Court ruling a question is not properly brought before the United States Supreme Court where it was not raised on appeal to the Court of Appeals. In his appeal to the CAFC Petitioner did not even raise the purported "heavy docket" bias and the purported "complex subject matter" bias. These allegations have now appeared for the first time in the present Petition for Certiorari. They were totally absent from his brief and oral arguments in his appeal to the CAFC, as well as his petition for rehearing to the CAFC. It was only after receiving an adverse decision of the CAFC that Petitioner raised these heretofore unexpressed and recently fabricated allegations. Quite obviously these allegations are directly attributable to the adverse judgment of the CAFC rather than any actual defect in the manner of conduct of the prior proceedings by either the District Court or the CAFC.

THE ALLEGATIONS OF DENIAL OF DUE PROCESS BY THE DISTRICT COURT ARE SPECIOUS AND REPLETE WITH FALSE REPRESENTATIONS

As one of his allegations of denial of due process Petitioner faults the District Court for taking more than a

year from the conclusion of trial until entering its Notice of Intended Judgment and Order Thereon (Petition, footnote 12, page 9). This statement is false. The presentation of evidence was concluded somewhat after 5:00 PM on Friday, May 3, 1991. The District Court, with the concurrence of Petitioner's counsel, requested closing arguments to be submitted in writing and established a briefing schedule for closing arguments according to which Petitioner's rebuttal would have been due on May 22, 1991. Petitioner's counsel, subsequently filed a stipulated request for an extension of this date to July 8, 1991. This was the date on or about which Petitioner filed his rebuttal closing argument and at which time trial was concluded.

Thus, Petitioner's statement that the District Court did not render its initial Notice of Intended Judgment of May 29, 1992 for more than a year after trial is blatantly false.

Furthermore, Petitioner's objection to the lapse of time, from July 8, 1991 to May 29, 1992, at which time the District Court issued its initial Notice of Intended Judgment is most curious. Petitioner waited more than six years before bringing any charge of infringement against the Respondent Cablestrand and more than eleven years before bringing any charge of infringement against the Respondent Weiss. Moreover, in his petition Petitioner states that the issues were complex. Nevertheless, he faults the District Court for taking a number of months to consider these complex issues before issuing the Notice of Intended Judgment.

Petitioner also stated in his petition that more than two years elapsed before the District Court complied with the CAFC's mandate to issue findings of fact and conclusions of law under Rule 52(a) of the Federal Rules of Civil Procedure (Petition, Footnote 12, page 9). The CAFC issued this mandate on March 8, 1993. The District Court complied with that mandate with its findings of fact and conclusions of law on May 28, 1993. Thus, the District Court complied with the mandate within about two and a half months, not more than two years as Petitioner falsely alleges.

Petitioner further alleges, without authority, that the District Court's partial reversal of its own judgment is totally contrary to law. This is absolutely untrue. Rule 52(b) of the Federal Rules of Civil Procedure specifically provides that when findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may *thereafter* be raised whether or not the party raising the question has made in the District Court an objection to such findings or has made a motion to amend them or a motion for judgment.

Respondents in their appeal from the initial Notice of Intended Judgment, and Petitioner in his cross-appeal from that same order, both urged the District Court to reverse itself on the respective portions of that order which did not favor them. Both parties filed motions in the District Court urging the District Court to accept copies of the appeal briefs which the parties had previously submitted to the CAFC prior to its decision of March 8, 1993. In Petitioner's motion to the District Court, filed on or about March 30, 1993, urging the Court

to accept briefs of the parties and the Appendix, Petitioner's counsel stated:

> "the parties have expended much time, effort, and money in preparing the foregoing briefs and Appendix to set forth their best arguments concerning the key liability issues in this litigation. It is believed that the briefs and such additional materials may be of interest and assistance in the preparation of the findings and conclusions."

Thus, Petitioner's argument that the reversal by the District Court of its own Judgment I "is totally contrary to law", not only lacks any legal authority, but is utterly hypocritical, since Petitioner specifically urged the Court to reverse that portion of the Notice of Intended Judgment that did not favor him.

Petitioner's argument that the District Court's action was "ultra vires" is utterly without merit. Petitioner alleges that there was a ten-day time limit within which the District Court could have reversed its initial determination. Petitioner cites no precedent to support this argument. Petitioner instead refers to Rule 59 of the Federal Rules of Civil Procedure. However, that Rule relates only to a court ordering a new trial within ten days after entry of judgment (FRCP Rule 59(a)-(d)) and with motions to alter or amend a judgment (FRCP Rule 59(e)). Petitioner made no motion for a new trial within the ten-day time limit provided in Rule 59(b), nor at any other time, and the Court did not order a new trial at any time. There was no motion by any party for alteration or amendment of the judgment.

While Rule 59 of the Federal Rules of Civil Procedure has no applicability in this case, Rule 60(a) does. As explained by the District Court in the Introduction to its Findings of Fact and Conclusions of Law:

> "On or about May 29, 1992, this Court issued a Notice of Intended Judgment along with an Order for additional briefing on the issue of damages. Upon receipt of the written memorandum of points and authorities the Court intended to prepare and file its complete Findings of Fact and Conclusions of Law and its Judgment. The Notice of Entry stamp under F.R.C.P. Rule 77(d) was erroneously placed by the clerk."

The District Court never intended for its Notice of Intended Judgment and Order Thereon to be a final, appealable judgment, although due to a clerical error it was indicated as such. The District Court properly corrected this error on its own initiative in its Findings of Fact and Conclusions of Law, which Rule 60(a) provides can be done at any time. As provided by Rule 60(a) of the Federal Rules of Civil Procedure this correction was delayed until the remand since, without leave of the Appellate Court, the District Court could not have made this correction while both Petitioner's and Respondents' appeals of the order of May 29, 1992, were still pending. The District Court's actions were entirely in accordance with Rule 60(a) which was applicable in this case and which covers corrective measures to be taken to remedy clerical mistakes, such as occurred here.

Since the order of May 29, 1992, was never intended to constitute a final judgment, the District Court was free

to consider further its ultimate judgment and revise its intended holding if warranted. In any event the CAFC properly vacated the order of May 29, 1992, so that order was null and void and of no further force or effect. Petitioner cites no specific authority to support his assertion at page 20 of the Petition that the action of the District Court was an unwarranted reversal and totally contrary to law. Indeed, there are no authorities to support Petitioner's position.

In addition to attacking the substance of the findings of fact and conclusions of law filed by the District Court on May 28, 1993, Petitioner maintains that the fact that the District Court chose to adopt some of the Respondent's proposed findings which the applicable Local Rules of the District Court require to be filed somehow taints these findings. This is simply not the law.

The U.S. District Court for the Central District of California, like many of the Federal District Courts, has implemented a specific rule, Local Rule 9.5, that *requires* the parties to submit proposed findings of fact and conclusion of law prior to trial. The purpose of this rule is not to require the parties to file needless papers which, having been prepared with great time, effort and expense to the litigants, the District Court should thereupon ignore. Quite to the contrary, the purpose of this rule is to allow each party to best present the concise facts it proposes to prove and a concise statement of the applicable law as it relates to those facts as an aid to the District Court in reaching its own findings.

Contrary to Petitioner's assertion, there was nothing sinister or unusual in the methodology adopted by the

District Court in examining the proposed findings and conclusions of the parties and in picking and choosing from among them those which the court deemed to have been adequately proven. *Indeed, that is the entire purpose behind requiring the litigants to file proposed findings and conclusions.*

Petitioner falsely asserts that the District Court performed a "wholesale adoption of the prevailing parties proposed findings". Quite to the contrary, the District Court quite evidently selected only those proposed findings and conclusions which it believed were supported by the evidence and which stated the applicable law. Indeed, the District Court declined to adopt any one of the Respondents' proposed findings and conclusions concerning the issue of validity of the patents in suit, which was tried by the District Court.

At the close of evidence at trial The District Court in instructing counsel regarding their closing statements, specifically called their attention to the proposed findings of fact and conclusion of law that the parties had previously filed prior to trial. The District Court directed the parties to:

> "review the findings of fact and conclusions of law to determine whether it is current as far as your position is concerned. And I strongly urge that as far as the findings of fact and conclusions of law are concerned, let's stress brevity and simplicity." (T.R. Vol. IV, p. 196, l. 1-5).

At the time Petitioner voiced no objection to the intent of the District Court to render brief, simple findings and use the parties' proposed findings. Petitioner

only made such objections after his own findings were not adopted.

Petitioner goes on to state that by adopting some, but certainly not all, of the findings of fact and conclusions of law proposed by Respondents, the District Court was taking "the path of least resistance." This is totally illogical, since the District Court could just as easily have adopted Petitioner's proposed findings had it found in Petitioner's favor and if the evidence had supported such findings.

Petitioner then makes the absurd statement that adoption of the proposed findings of fact and conclusions of law would dispose of the matter while minimizing the probability of appeal. This is ridiculous since Petitioner had previously appealed when only a portion of the initial Notice of Intended Judgment was against him. Petitioner then makes the further false statement that by adopting the proposed findings the District Court would not have to resolve complex issues in the case. However, the District Court did indeed resolve each and every one of the salient issues in the litigation.

Petitioner states that the findings did not contain any reference to the evidence proffered at trial or to the trial transcript. He apparently objects to the fact that the findings do not cite specific exhibits or specific pages of the trial transcript testimony. However, there is no requirement whatsoever that this should be done.

Quite to the contrary, and as stated in the notes of the Advisory Committee on Rules with respect to FRCP Rule 52, the judge need only make brief, definite, pertinent findings and conclusions upon the contested matter;

there is no necessity for over-elaboration of detail or particularization of facts. *United States v. Forness*, 125 F. 2d 928, (CA 2 1942) cert. den. 316 U.S. 694, 62 S. Ct. 1293, 86 L. Ed. 1764; *Peterson, Lighterage & Towing Corp. v. New York Central R. Co.*, 126 F. 2d 992 (CA 2 1942); *Brown Paper Mill Co., Inc. v. Irwin*, 134 F. 2d 337 (CA 8 1943); *Allen Bradley Co. v. Local Union No. 3, I.B.E.W.*, 145 F. 2d 215 (CA 2 1944), reversed on other grounds 325 U.S. 797, 65 S. Ct. 1533; and *Young v. Murphy*, 9 Fed Rules Serv. 52a.11, Case 2, 1946. In raising this objection to the findings the only authority cited by Petitioner is an essay of Sir Francis Bacon from the year 1597. Clearly, such a citation has no relevance to the Federal Rules of Civil Procedure.

Petitioner alleges "irregular" actions of the District Court, yet has shown no action by the District Court that was inconsistent with the Federal Rules of Civil Procedure.

THE ALLEGED "BIASES" ATTRIBUTED TO BOTH THE DISTRICT AND APPELLATE COURTS ARE TOTAL FABRICATION

While Petitioner now attributes to the District Court a concocted "complex subject matter bias" and "heavy docket bias" he did not raise any such purported issues in his appeal to the CAFC. Interestingly, in Footnote 28, he states that District Courts have been known to voice their opinions, even on the record, that they "dislike" technically complex cases, most frequently, patent cases. However, he apparently found no such statement on the record by this District Court, since he makes no reference to the record of this case in this connection. Indeed, Petitioner has shown not the slightest indication that the

judgment of either the District Court or the Appellate Court was motivated by any bias.

Petitioner's purported "biases" are totally illusory and intended to distract this Court from the plain and simple fact that the District Court did not consider Petitioner's witnesses, other evidence, and arguments to be credible. The CAFC properly concurred that indeed Petitioner had failed to prove the threshold issue of infringement, which was totally dispositive of the case.

CONCLUSION

Petitioner's Petition for Certiorari is not worthy of consideration by this Court. It is nothing more than a frivolous attempt to foist upon this Court further consideration of Petitioner's meritless claims which he has thus far failed to prove. Nothing has been shown to warrant an exercise of this Court's power of supervision. Petitioner is merely seeking yet another tribunal before which to press claims which are unsupported by the relevant evidence.

For all of the foregoing reasons Respondents urge the Court to summarily deny Petitioner's Petition for Certiorari.

Date: January 3, 1995

Respectfully submitted,

CHARLES H. THOMAS
Attorney for Respondents
Cablestrand Corporation
and
Allan B. Weiss

CISLO & THOMAS
Suite 405
4201 Long Beach Boulevard
Long Beach, California 90807-2007
(310) 595-8422